



05-26-09

DAC

Attorney Docket No.: A00215 Con 2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: David A. Connolly

#24

Title: WIRELESS DIGITAL PERSONAL COMMUNICATIONS SYSTEM HAVING
VOICE/DATA/IMAGE TWO-WAY CALLING AND INTERCELL HAND-OFF PROVIDED THROUGH
DISTRIBUTED LOGIC RESIDENT IN PORTABLE HANDSET TERMINALS, FIXED TERMINALS,
RADIO CELL BASE STATIONS AND SWITCHED TELEPHONE NETWORK

App. No.: 08/926,187

Filed:

Sept. 8, 1997

Examiner: TROST, William G.

Group Art Unit: 2744

RECEIVED

Customer No.: 60533

Confirmation No.: unknown

JUN 02 2009

Atty. Dkt. No.: A00215 Con 2

OFFICE OF PETITIONS

MS: Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO REVIVE UNAVOIDABLY ABANDONED APPLICATION

Dear Sir:

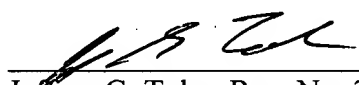
In response to the Notice of Abandonment mailed May 24, 2000, please find enclosed herewith:

- This transmittal form (1 page);
- Fee transmittal (in duplicate, 2 pages);
- Statement Under 37 CFR 3.73(b) and Power of Attorney document (3 pages)
- Petition to Revive Unavoidably Abandoned Application (8 pages)
- Exhibits (with index, 89 pages)

Respectfully submitted,

Date

5-21-2009


Jeffrey G. Toler, Reg. No. 38,342
Attorney for Applicant(s)
Toler Law Group, Intellectual Properties
8500 Bluffstone Cove, Suite A201
Austin, Texas 78759
(512) 327-5515 (phone)
(512) 327-5575 (fax)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: David A. Connolly

#24 cont'd

Title: WIRELESS DIGITAL PERSONAL COMMUNICATIONS SYSTEM HAVING VOICE/DATA/IMAGE TWO-WAY CALLING AND INTERCELL HAND-OFF PROVIDED THROUGH DISTRIBUTED LOGIC RESIDENT IN PORTABLE HANDSET TERMINALS, FIXED TERMINALS, RADIO CELL BASE STATIONS AND SWITCHED TELEPHONE NETWORK

App. No.: 08/926,187

Filed: Sept. 8, 1997

Examiner: Trost, William G.

Group Art Unit: 2744

Customer No.: 60533

Confirmation No.: unknown

Atty. Dkt. No.: A00215 Con 2

RECEIVED

MS: Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

JUN 02 2009

OFFICE OF PETITIONS**PETITION TO REVIVE ABANDONED APPLICATION**

Dear Sir:

This petition, submitted pursuant to 37 C.F.R. §1.137(a), or in the alternative, pursuant to 37 C.F.R. §1.137(b), is in response to a Notice of Abandonment mailed on May 24, 2000 regarding the above-identified application.

BACKGROUND

The Office mailed a Notice of Allowability and a Notice of Allowance and Issue Fee Due on July 15, 1999. The Notice of Allowability indicated that claims 1-27 of the application were allowed. The Notice of Allowance and Issue Fee Due indicated that the fees due totaled \$1210.00. On May 24, 2000, the Notice of Abandonment was mailed indicating that the issue fee had not been received.

The Assignee directed Mr. William Prendergast, the Assignee's representative at the time, to pay the Issue Fee. In response, Mr. Prendergast provided apparently fraudulent information to the Assignee indicating that the Issue Fee had been paid. For example, EXHIBIT 1 is a letter from Mr.

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U.S. App. No.: 08/926,187

Prendergast to Applicant's in-house attorney in which Mr. Prendergast acknowledges receiving instructions to pay the issue fee and indicates that the issue fee was paid. The U.S. Patent and Trademark Office (USPTO) File Wrapper for the Application does not include any document indicating that the Issue Fee was paid; however, the records of Mr. Prendergast include documents with USPTO stamps indicating that the Issue Fee payment was timely mailed on October 15, 1999 and stamped received by the USPTO on November 5, 1999. *See, EXHIBIT 2 - Apparently Falsified Issue Fee Transmittal and Return Post Card.* Based on the information available, it appears that Mr. Prendergast provided falsified information to the Assignee, to members of Mr. Prendergast's law firm, and to the law firm's records and docketing department.

REMARKS

Applicant hereby petitions the Commissioner to revive the Application under 37 C.F.R. §1.137(a) as unavoidably abandoned. In the alternative, Applicant hereby petitions the Commissioner to revive the Application under 37 C.F.R. §1.137(b) as unintentionally abandoned.

UNAVOIDABLE DELAY

The Commissioner is authorized by 35 U.S.C. §151 to accept a delayed payment of the issue fee as though no abandonment or lapse had ever occurred when the delayed payment is shown to have been unavoidable. The Manual of Patent Examination Procedures (MPEP), at §711.03(c) indicates what circumstances constitute an unavoidable delay. In particular, MPEP §711.03(c)(II)(c)(2), quoting *In re Mattullath*, 38 App. D.C. 497, 514-15 (1912)(quoting *Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)), states that:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In *In Re Application of Robert Lonardo* ("Lonardo"), the Commissioner discussed the law applied by the USPTO regarding whether a delay is unavoidable under certain circumstances. *See,*

EXHIBIT 3 - Petition Decision in In Re Application of Robert Lonardo, accessed from http://ipmall.info/hosted_resources/commissioner_decisions/cd_141.htm on March 30, 2009. In *Lonardo*, the issues were: 1) whether the Applicant was diligent, 2) whether the Attorney was diligent, and 3) whether the Attorney's lack of diligence was attributable to the Applicant. *Lonardo*, p. 1 (Pinpoint citations within the Petition Decision are with reference to the document attached at EXHIBIT 3 as the original document could not be accessed). Lonardo petitioned the USPTO to revive his abandoned patent application as unavoidably abandoned approximately 14 years after the application became abandoned due to the failure of Lonardo's attorney, Schwartz, to provide formal drawings. *Id.* After becoming aware that the Lonardo application was abandoned, Schwartz attempted to cover up his error by filing a new application. *Id.*, at p. 2. The USPTO found that Lonardo exercised due care in the application, but Schwartz did not. *Id.*, at p. 2-3. Further, the USPTO found that Schwartz's lack of diligence could not be attributed to Lonardo because Schwartz intentionally concealed his mistake, citing *Jackson v. Washington Monthly Co.*, 569 F.2d 119, 122, n. 18 (D.C.Cir. 1977). *Id.*, at p. 3-4. Additionally, the USPTO found that the Schwartz failure to file the required response was unavoidable due to his inability to perform his responsibilities. *Id.*, at p. 4-6. Accordingly, Lonardo's application was revived. *Id.*, at p. 1.

The unusual facts of the present Application are similar to the Lonardo application in that the Applicant was diligent but the Attorney was apparently unable to perform his duties and as a result was not diligent in providing a required response and subsequently attempted to cover his failure by deception. Accordingly, Applicant requests revival of the Application as unavoidably abandoned. The following facts and arguments address the Applicant's diligence with respect to payment of the issue fee, the Attorney's diligence with respect to the payment of the issue fee, the Attorney's diligence with respect to filing a grantable petition, and the Applicant's diligence with respect to filing a grantable petition. Based on the specific facts present, Applicant respectfully requests revival of the Application as unavoidably abandoned.

Applicant's diligence with respect to payment of the issue fee

Applicant respectfully submits that, at the time the issue fee was due, Applicant had exercised appropriate care in entrusting prosecution of the Application to Mr. Prendergast. Mr. Prendergast had been registered to practice before the USPTO as a Patent Attorney (reg. no. 34,699) for about 8 years at the time the issue fee became due. *See, EXHIBIT 4 - USPTO Registration Information for William F. Prendergast* (showing the date of Mr. Prendergast's registration to practice before the USPTO). Thus, based on Mr. Prendergast's USPTO registration and his experience, entrusting Mr. Prendergast to pay the issue fee represented the exercise of due care. Additionally, entrusting Mr. Prendergast's law firm, Brinks Hofer Gilson and Lione, to pay the issue fee represented the exercise of due care. According to the firm's history at the web page for Brinks Hofer Gilson and Lione, when the issue fee came due, the firm had approximately 80 years of experience prosecuting patents, having been established in 1917 as a patent law firm. *See, EXHIBIT 5 - Brinks Hofer Gilson and Lione Firm History Webpage*. Thus, entrusting Brinks Hofer Gilson and Lione to pay the issue fee represented exercise of due care. Further, the Applicant was diligent in specifically instructing Mr. Prendergast and, through Mr. Prendergast, Brinks Hofer Gilson and Lione, to pay the issue fee. *See, EXHIBIT 1* (acknowledging receipt of instructions to pay the issue fee). Accordingly, Applicant exercised appropriate care and diligence to ensure timely payment of the issue fee.

Attorney's diligence with respect to payment of the issue fee

Despite the Applicant's diligence, the Application went abandoned as a result of Mr. Prendergast's apparent failure to pay the issue fee as instructed. Although at the time the issue fee came due, entrusting Mr. Prendergast with payment of the issue fee was appropriate exercise of care, evidence has since come to light indicating that Mr. Prendergast was not able to perform his duties. For example, during the course of investigating Mr. Prendergast's actions, attorneys at Brinks Hofer Gilson and Lione have identified more than 20 client matters that were apparently abandoned by Mr. Prendergast without proper authorization from the client. *See, EXHIBIT 6 - Redacted Brinks Hofer Gilson and Lione WFP Investigation Status Report*; and *EXHIBIT 9 - Declaration of David S. Fleming*, paragraphs 9 and 10. There are indications that Mr. Prendergast attempted to cover his actions with respect to these abandoned applications using false written or oral statements. *Id.*

In *Lonardo* evidence was presented that at least seven other patent applications prosecuted by Schwartz had become abandoned due to Schwartz's failure to prosecute the applications. *See, EXHIBIT 3*, at p. 5. All seven of these applications were subsequently revived based on the USPTO's finding of Schwartz's "inability to perform his responsibilities" as evidenced by the number of client matters that he failed to prosecute properly. *Id.*, at p. 5-6. Applicant respectfully submits that Mr. Prendergast's actions with respect to the more than twenty client matters identified by Brinks Hofer Gilson and Lione as inappropriately abandoned demonstrate Mr. Prendergast's inability to perform his responsibilities. Accordingly, Mr. Prendergast's failure to pay the issue fee is excusable as unavoidable, as was Schwartz's in *Lonardo*, because of Mr. Prendergast's apparent inability to perform his responsibilities.

Attorney's diligence with respect to filing a grantable petition

After the Application became abandoned, rather than take steps to revive the Application, Mr. Prendergast appears to have generated a series of falsified documents that were included in the Brinks Hofer Gilson and Lione file for the Application and provided to Applicant. For example, Mr. Prendergast indicated via oral and written communications that he paid the issue fee and supported his assertions by apparently generating a false issue fee transmittal and return post card, complete with an apparently falsified USPTO received stamp, indicating that the issue fee was paid. *See, EXHIBIT 2*. Additionally, Mr. Prendergast apparently falsified a Petition for Withdrawal of the Erroneous Holding of Abandonment, again complete with an apparently falsified USPTO received stamp indicating that the Petition had been filed. *See, EXHIBIT 7 - Apparently Falsified Petition for Withdrawal of the Erroneous Holding of Abandonment and Return Post Card*. Further, Mr. Prendergast repeatedly provided telephone or electronic mail communications to other attorneys within Brinks Hofer Gilson and Lione and to the Applicant indicating that various communications regarding the Application had been conducted with USPTO personnel. *See, EXHIBIT 8 - Selection of Redacted Electronic Mail Referencing Communications between Mr. Prendergast and USPTO*. Thus, Mr. Prendergast appears to have taken steps to actively deceive the Applicant regarding the status of the Application.

Moreover, while Brinks Hofer Gilson and Lione had in place a business process for paying issue fees that could reasonably be relied upon to avoid accidental non-payment of issue fees, Mr.

Prendergast also took steps to defeat that business process. For example, Brinks Hofer Gilson and Lione used a docketing system that generated a "pink card" for open docket items, including issue fees due. *See, EXHIBIT 9*, at item 5. To clear an item from the docket, the associated pink card had to be returned to a docket clerk with a signature of a party that performed the action. *Id.* A copy of the pink card for the issue fee in this Application is attached at EXHIBIT 10. The pink card was apparently initialed by Mr. Prendergast ("WFP" for William F. Prendergast) indicating that the issue fee was paid. *Id.* Thus, Mr. Prendergast appears to have taken active steps to deceive Applicant and his law firm to avoid detection of the true status of the application.

In *In Re Application of Robert Lonardo*, the Commissioner found that the attorney's intentional actions to conceal his failure deprived the client of an opportunity to cure the consequences of the attorney's failure; thus, the attorney's failure to revive the application was not attributed to the client. *See, EXHIBIT 3*, at p. 3-4. Likewise in the present Application, Mr. Prendergast's intentional acts to deceive the Applicant deprived the Applicant of an opportunity to cure the failure by reviving the Application. Accordingly, Mr. Prendergast's failure to file a grantable petition to revive the Application should not be attributed to the Applicant, and the Application should be revived as unavoidably abandoned.

Applicant's diligence with respect to filing a grantable petition

After determining that Mr. Prendergast had not been entirely truthful, the Applicant was further delayed in filing a grantable petition as a result of uncertainty as to which documents in Brinks Hofer Gilson and Lione's file for the Application were genuine and which were falsified. Only after extensive investigation of the circumstances and comparison of the law firm's files to the USPTO file wrapper could an understanding of the nature and scope of Mr. Prendergast's activities be understood.

Mr. Prendergast has been referred to the Attorney Registration and Disciplinary Commission of the Supreme Court of Illinois and to the USPTO Office of Enrollment and Discipline for disciplinary proceedings for his activities. *See, EXHIBIT 9*, at item 12. Accordingly, no signed declaration by Mr. Prendergast is available to attest to the events that caused the delay in paying the issue fee. As a substitute for Mr. Prendergast's declaration, a signed declaration is provided from David S. Fleming, an attorney and shareholder at Brinks Hofer Gilson and Lione who was involved

in the investigation of Mr. Prendergast's activities with respect to this Application as well as others. *See, EXHIBIT 9*, at item 1 and 2.

Based on the above recited facts and arguments, Applicant submits that the entire delay in paying the issue fee from the due date of the issue fee until the filing of a grantable petition pursuant to 37 CFR §1.137(a) was unavoidable. The evidence presented herein demonstrates that the Application was unavoidably abandoned. Additionally, the evidence demonstrates that the Applicant has been diligent since becoming aware that the Application was abandoned and has used due care and diligence to petition the Office to revive the Application. Accordingly, Applicant hereby requests that the Application be revived as unavoidably abandoned.

UNINTENTIONAL DELAY

The Commissioner is authorized, by 35 U.S.C. §41(a)(7), to revive an abandoned patent application as unintentionally abandoned for the unintentionally delayed payment of a fee for issuing the patent. Applicant submits that the entire delay in paying the required issue fee from the due date for the issue fee until the filing of a grantable petition pursuant to 37 CFR §1.137(b) was unintentional.

The evidence presented above demonstrates that the Application was abandoned unintentionally. For example, the Applicant specifically instructed Mr. Prendergast, and through him, the law firm of Brinks Hofer Gilson and Lione to pay the issue fee. *See, EXHIBIT 1* (acknowledging receipt of instructions to pay the issue fee). Additionally, Applicant has been diligent since becoming aware that the Application was abandoned and has used due care and diligence to petition the Office to revive the Application. Accordingly, Applicant hereby requests that the Application be revived as unintentionally abandoned.

CONCLUSION

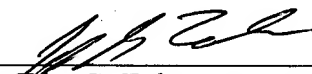
Applicant respectfully requests revival of the Application under 37 CFR §1.137(a) as unavoidably abandoned. In the alternative, if the request for revival of the Application under 37 C.F.R. §1.137(a) is denied, Applicant respectfully requests revival of the Application pursuant to 37 CFR §1.137(b) as unintentionally abandoned.

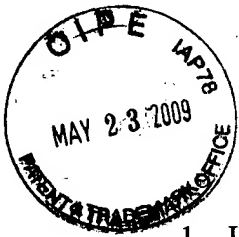
If a call would in any way facilitate revival of this Application, the Office is invited to contact the current Attorney of Record.

Applicant does not believe that any additional fees are due, but if the Commissioner believes additional fees are due, the Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

5-22-2009
Date


Jeffrey G. Toler, Reg. No. 38,342
Attorney for Applicant
TOLER LAW GROUP
8500 Bluffstone Cove, Suite A201
Austin, Texas 78759
(512) 327-5515(phone)
(512) 327-5575 (fax)



INDEX OF EXHIBITS:

RECEIVED

JUN 02 2009

OFFICE OF PETITIONS

1. Letter Acknowledging Instructions to pay Issue Fee
2. Apparently Falsified Issue Fee Transmittal and Return Post Card
3. Petition Decision in *In Re Application of Robert Lonardo*
4. USPTO Registration Information Webpage regarding William F. Prendergast
5. Brinks Hofer Gilson and Lione Firm History Webpage
6. Redacted Brinks Hofer Gilson and Lione WFP Investigation Status Report
7. Apparently Falsified Petition for Withdrawal of the Erroneous Holding of Abandonment and Return Post Card
8. Selection of Redacted Electronic Mail Referencing Communications between Mr. Prendergast and USPTO
9. Declaration of David S. Fleming in Support of the Petition to Revive U.S. Patent Application No. 08/926,187
10. Copy of Brinks Hofer Gilson and Lione docket "pink card" for Application

EXHIBIT 1

Letter Acknowledging Instructions to pay Issue Fee

William F. Prendergast
312-321-4242
EMAIL: WFP@brinkshofer.com

BRINKS
HOFFER
GILSON
& LIONE

October 15, 1999

VIA FEDERAL EXPRESS

Bruce Stuckman, Esq.
Ameritech Services, Inc.
2000 West Ameritech Center Drive
Hoffman Estates, IL 60196-1025

**RE: U.S. Patent Application Entitled:
WIRELESS DIGITAL PERSONAL COMMUNICATIONS
SYSTEM HAVING VOICE/DATA/IMAGE TWO-WAY CALLING
AND INTERCELL HAND-OFF PROVIDED THROUGH
DISTRIBUTED LOGIC RESIDENT IN PORTABLE HANDSET
TERMINALS, FIXED TERMINALS, RADIO CELL BASE
STATIONS AND SWITCHED TELEPHONE NETWORK
Our File No. 8285/153**

A PROFESSIONAL CORPORATION
INTELLECTUAL PROPERTY ATTORNEYS

NBC TOWER - SUITE 3600
455 N. CITYFRONT PLAZA DRIVE
CHICAGO, ILLINOIS 60611-5599
brinkshofer.com
FAX 312-321-4299
TELEPHONE 312-321-4200

SAN JOSE, CA
INDIANAPOLIS, IN
ANN ARBOR, MI
ARLINGTON, VA

Dear Bruce:

Pursuant to your instructions we have paid the issue fee for the above-identified application. Please let me know if you have any questions. Please let me know if you have any questions.

Sincerely,



William F. Prendergast

WFP

EXHIBIT 2

Apparently Falsified Issue Fee Transmittal and Return Post Card

TRANSMITTAL LETTER			Case No. 8285/153
Serial No. 08/926,187	Filing Date: 09/09/97	Examiner Trost	Group Art Unit 2744
Inventor(s) Connolly et al.			
Title of Invention Wireless Digital Personal Communications System			

TO THE ASSISTANT COMMISSIONER FOR PATENTS

Transmitted herewith is PTOL-85B (dupl.); Return Post Card.

- ☐ Small entity status of this application under 37 CFR § 1.27 has been established by verified statement previously submitted.
- ☐ A verified statement to establish small entity status under 37 CFR §§ 1.9 and 1.27 is enclosed.
- ☐ Petition for a _____ month extension of time.
- ☒ No additional fee is required.
- ☐ The fee has been calculated as shown below:

	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra
Total		Minus		
Indep.		Minus		
First Presentation of Multiple Dep. Claim				

Small Entity

Rate	Add'l Fee
x \$9 =	
x 39 =	
+ \$130 =	
Total add'l fee	\$

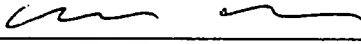
or

Other Than
Small Entity

Rate	Add'l Fee
x \$18 =	
x \$78 =	
+ \$260 =	
total add'l fee	\$

- ☒ Please charge Deposit Account No. 23-1925 (BRINKS HOFER GILSON & LIONE) in the amount of \$ 1340. A duplicate copy of this sheet is enclosed.
- ☐ A check in the amount of \$ to cover the filing fee is enclosed.
- ☒ The Assistant Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this communication or credit any overpayment to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.
- ☒ I hereby petition under 37 CFR § 1.136(a) for any extension of time required to ensure that this paper is timely filed. Please charge any associated fees which have not otherwise been paid to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.

Respectfully submitted,


 William F. Prendergast
 Registration No. 34,699
 Attorney for Applicant

BRINKS HOFER GILSON & LIONE
 P.O. BOX 10395
 CHICAGO, ILLINOIS 60610
 (312) 321-4200

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on October 15, 1999.

Date:

10/15/99

Signature:



Case No. 8285/153
Applicant Connolly et al.

Hon. Commissioner of Patents & Trademarks
Washington, D.C. 20231

Please acknowledge receipt of the below-identified:

Serial No: 08/926,187

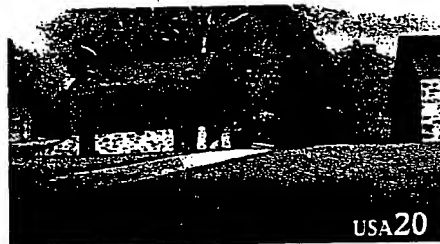
PTOL-85b (DUPL.); Issue Fee 1340; Return Post Card

BRINKS HOFER GILSON & LIONE

By: W. F. Prendergast/mal

Date of Mailing: October 15, 1999

RECEIVED
NOV -5 1999
TECH CENTER 2700



BRINKS HOFER GILSON & LIONE

A PROFESSIONAL CORPORATION

P. O. BOX 10395

CHICAGO, ILLINOIS 60610

PART B—ISSUE FEE TRANSMITTAL

Complete and mail this form, together with applicable fees, to:

Box ISSUE FEE
Assistant Commissioner for Patents
Washington, D.C. 20231

MAILING INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE. Blocks 1 through 4 should be completed where appropriate. All further correspondence including the Issue Fee Receipt, the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Legibly mark-up with any corrections or use Block 1)

LM41/0715
WILLIAM F PRENDERGAST
BRINKS HOFER GILSON & LIONE
PO BOX 10395
CHICAGO IL 60610

Note: The certificate of mailing below can only be used for domestic mailings of the Issue Fee Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing.

Certificate of Mailing

I hereby certify that this Issue Fee Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Box Issue Fee address above on the date indicated below.

William Prendergast

(Depositor's name)

[Signature]

(Signature)

10/15/99

(Date)

APPLICATION NO.	FILING DATE	TOTAL CLAIMS	EXAMINER AND GROUP ART UNIT	DATE MAILED
08/926,187	09/09/97	077	TROST IV, W	2744 07/15/99
First Named Applicant	CONNOLLY, DAVID A.			

TITLE OF INVENTION WIRELESS DIGITAL PERSONAL COMMUNICATIONS SYSTEM HAVING VOICE/DATA/IMAGE TWO-WAY CALLING AND INTERCEL HAND-OFF

ATTY'S DOCKET NO.	CLASS-SUBCLASS	BATCH NO.	APPLN. TYPE	SMALL ENTITY	FEE DUE	DATE DUE
2 8285	455-461, 000	V/5	UTILITY	NO	\$1210.00	10/15/99

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363). Use of PTO form(s) and Customer Number are recommended, but not required.

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47) attached.

2. For printing on the patent front page, list (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1. *Brinks Hofer Gilson & Lione*
2. _____
3. _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)
PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. Inclusion of assignee data is only appropriate when an assignment has been previously submitted to the PTO or is being submitted under separate cover. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE *Ameritech Corporation*

(B) RESIDENCE: (CITY & STATE OR COUNTRY)

Hoffman Estates, IL

Please check the appropriate assignee category indicated below (will not be printed on the patent)

☐ individual ☒ corporation or other private group entity ☐ government

4a. The following fees are enclosed (make check payable to Commissioner of Patents and Trademarks):

☒ Issue Fee
☒ Advance Order - # of Copies *10*

4b. The following fees or deficiency in these fees should be charged to:

DEPOSIT ACCOUNT NUMBER *23-1925*
(ENCLOSE AN EXTRA COPY OF THIS FORM)

☒ Issue Fee
☒ Advance Order - # of Copies *10*

The COMMISSIONER OF PATENTS AND TRADEMARKS IS requested to apply the Issue Fee to the application identified above.

(Authorized Signature)

(Date)

[Signature] *10/15/99*
NOTE: The Issue Fee will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the Patent and Trademark Office.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending on the needs of the individual case. Any comments on the amount of time required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, D.C. 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND FEES AND THIS FORM TO: Box Issue Fee, Assistant Commissioner for Patents, Washington D.C. 20231

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMIT THIS FORM WITH FEE

EXHIBIT 3

Petition Decision in *In Re Application of Robert Lonardo*

Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

IN RE APPLICATION OF ROBERT LONARDO
Serial No. 399,365
August 6, 1990
*1 Filed: September 21, 1973

For: THERAPEUTIC LEG AND FOOT DEVICE

Zarley, McKee, Thomte, Voorhees & Sease

2400 Ruan Center

Des Moines, Iowa 50309

James E. Denny

Deputy Assistant Commissioner for Patents

ON PETITION

The above-identified application ('365 application), naming Robert Lonardo as inventor, became abandoned on March 8, 1974, for failure to file formal drawings within a two-month period specified in an office communication dated January 7, 1974. On November 21, 1988, Lonardo filed a petition to revive the '365 application under 37 CFR § 1.137(a), which was denied on April 18, 1989. On May 4, 1989, Lonardo filed a further petition to revive the '365 application and a petition under 37 CFR § 1.183 to waive applicable rules, both of which were denied on August 4, 1989.

Lonardo then filed suit against the Commissioner in the United States District Court, Middle District of Florida (Civil Action No. 89-1329-CIV-T- 13C), seeking a court order directing the Commissioner to revive the abandoned '365 application. On May 4, 1990, the district court granted the Commissioner's unopposed motion for stay and remand, and permitted the Patent and Trademark Office (PTO) three months to consider recently discovered additional evidence which might lead to granting of relief by the Commissioner. On June 1, 1990, Lonardo filed a renewed petition to revive the abandoned '365 application.

Lonardo's renewed petition to revive is GRANTED.

To revive an abandoned patent application under 37 CFR § 1.137(a), the petitioner must establish that his application became abandoned due to "unavoidable delay." Proper considerations include the extent of diligence exhibited by the petitioner himself and by his attorney, in connection with the delay for which the application became abandoned and also with their respective efforts to revive the abandoned application. The diligence of the attorney is relevant because one is ordinarily bound by the acts of his attorney. See *Link v. Wabash R.R.*, 370 U.S. 626, 633-34, reh'g denied, 371 U.S. 873 (1962); *Smith v. Mossinghoff*, 671 F.2d 533, 5 USPQ2d 1130 (D.C.Cir.1982); *Haines v. Quigg*, 673 F.Supp. 314, 5 USPQ2d 1130 (D.Ind.1987); *Ex parte Stuckgold*, 1903 Dec. Comm'r Pat. 307, 308 (Comm'r Pat.1903).

In this decision, the diligence of Lonardo is first considered, followed by that of his attorney, Max Schwartz ("Schwartz"). If Schwartz had not been diligent, whether his lack of diligence is excused by sickness or incapacity, or otherwise not chargeable to Lonardo, is then considered.

Lonardo was diligent

*2 Mrs. Lonardo persistently acted as Lonardo's agent for communicating with Schwartz, in connection with Lonardo's invention. Accordingly, Mrs. Lonardo's acts on behalf of Lonardo, and her knowledge of information obtained from Max Schwartz, are imputed to Lonardo.

Nothing in the record indicates that Lonardo was aware of the Examiner's communication dated January 7, 1974, which set a two-month period for submission of formal drawings. Though Schwartz received the office communication, he did not notify Lonardo of the outstanding requirement, nor did he submit formal drawings within the stated two-month period. Unless Lonardo should have known that Schwartz could not be trusted with prosecution of the '365 application, Lonardo could not be reasonably expected to take actions which would have avoided the abandonment which occurred. The facts do not show that Lonardo should have known that Schwartz was professionally incompetent or otherwise unreliable. Consequently, it cannot be reasonably said that Lonardo contributed to the abandonment of the '365 application through his own lack of diligence.

The record also indicates that Lonardo was not less than diligent from the time of abandonment of the '365 application on March 8, 1974, to the time of filing of the substitute application on June 6, 1975, in not knowing that the '365 application had become abandoned. Lonardo suffered a heart attack in April of 1974, for which he needed the remainder of that year to recuperate. Through his wife, Lonardo attempted to contact Schwartz on numerous occasions in early 1975. Though Mrs. Lonardo had difficulty contacting Schwartz, she did manage to reach him by telephone on at least two occasions, once on March 24, 1975, and another time on April 1, 1975.

In the telephone conversation of March 24, 1975, Schwartz said he had been ill, apologized for neglecting his work, and stated that he would send a letter to Washington (presumably the PTO) to explain that he had been ill. In a note of even date with that telephone conversation, Mrs. Lonardo sent Schwartz a request for a copy of the letter Schwartz intended to send to Washington. In the telephone conversation of April 1, 1975, Schwartz assured Mrs. Lonardo that everything was fine and a patent would be issued momentarily. The second conversation was followed by another note from Mrs. Lonardo to Schwartz which urged Schwartz to call as soon as he had news about the patent to be issued. Those facts indicate that Lonardo was concerned about progress of the '365 application, made multiple inquiries to Schwartz, and was assured by Schwartz that all was well and there was no need to worry. Lonardo was not less than diligent.

Lonardo never followed up on his request of March 24, 1975, asking Schwartz to send a copy of the letter to Washington. That inaction may appear to reflect lack of diligence. However, an unfulfilled request for the copy reflects more, not less, diligence than not having made the request at all. Also, Schwartz's further assurance of April 1, 1975, obviated any pressing need for the copy. Lonardo already knew the intended content of the letter, i.e., that Schwartz would explain that he had been ill; Lonardo's main concern was whether the application would progress toward issuance. Schwartz's representations to Mrs. Lonardo on April 1, 1975, that all was well and the patent would issue momentarily gave Lonardo the assurance he needed. In that circumstance, a physical copy of the letter no longer has meaningful significance. Accordingly, Lonardo cannot be faulted for not further pursuing a copy of the letter Schwartz purported to be sending to Washington.

*3 In May 1975, instead of receiving a copy of Schwartz's alleged letter to Washington, Lonardo received from Schwartz a substitute application. Lonardo considered the various applications, whether a continuation-in-part (the '365 application was itself a continuation-in-art application of an earlier application) or a substitute, to be one single application process for obtaining a patent on his invention. To Lonardo, the substitute application was simply one other submission which was necessary to secure the issuance of a patent for his invention. From that perspective, the substitute application does not give notice to Lonardo that something had gone wrong in the application process.

Lonardo's not confronting Schwartz on why Schwartz sent a substitute application to be executed rather than a copy of the purported letter to Washington should not work toward Lonardo's detriment. The substitute application reflects further efforts expended by Schwartz to secure a patent for Lonardo's invention; Lonardo had insufficient basis to doubt its propriety. It cannot be reasonably said that Lonardo should have preferred to receive a copy of the purported letter to Washington, rather than the substitute application; while the former is intended as an explanation of Schwartz's illness, the latter represents a work product which brought Lonardo closer toward obtaining a patent. From Lonardo's perspective, the '365 application was being taken care of and was advancing toward issuance; whether he received a copy of Schwartz's letter to Washington, and even whether Schwartz had sent such a letter, are relatively inconsequential in that circumstance. Thus, Lonardo exhibited ample diligence toward securing issuance of a patent for his invention by promptly executing the substitute application on May 16, 1975.

Lonardo first learned of the abandoned status of the '365 application on September 20, 1988, from opposing counsel in a patent infringement action involving the patent which issued from the substitute application. For the period from the execution of the substitute application on May 16, 1975, to September 20, 1988, the record shows no reason for Lonardo to question the status of the '365 application. From Lonardo's perspective, there was a single patent application process which resulted in the issuance of the patent; whatever applications were involved in that process have merged into the resulting patent. It cannot be said that Lonardo was not diligent in the period from May 16, 1975, to September 20, 1988, in connection with not knowing that the '365 application had been abandoned.

Lonardo filed the first petition to revive the '365 application on November 21, 1988. Though two months have passed from the time when he first learned that the '365 application had gone abandoned, that does not constitute excessive delay in light of the need to gather facts relating to events of more than 14 years ago. Lonardo was not less than diligent in seeking to revive the '365 application, once the abandoned status of the application was made known to him on September 20, 1988.

*4 Also, based on this record, Lonardo had no reason not to retain Schwartz as his attorney or to rely on Schwartz throughout the prosecution of the '365 application. Though we find Schwartz to be unable to perform his responsibilities after April 1973, as discussed below, Lonardo did not know that and we cannot say that Lonardo should have known.

For the foregoing reasons, Lonardo's own conduct cannot be regarded as less than diligent and thus precluding him from establishing unavoidable delay under 37 CFR § 1.137(a).

Schwartz was not diligent

Schwartz received the office communication dated January 7, 1974, which set a two-month period for submission of formal drawings. Though Schwartz's status letter of April 15, 1974, referred to a prior request from Schwartz for the Examiner to order the transfer of formal drawings from an abandoned parent application, it did not indicate when the request was made nor whether the Examiner had agreed to take such action. Indeed, the last paragraph of the letter suggested that no agreement had been reached with the Examiner, in stating: "[p]lease advise whether an action will be forthcoming in accordance with the above [pending request for the Examiner to order the transfer of formal drawings from the parent application]." Because formal drawings were not filed by March 7, 1974, the '365 application became abandoned. On this record, Schwartz had not been diligent, and his lack of diligence caused the abandonment of the '365 application.

Though a patent office communication dated May 2, 1984, was sent to Schwartz, which noted that the '365 application had become abandoned, Schwartz's file for the '365 application does not contain that official communication. Nevertheless, sometime between April 15, 1974, and May 1975, Schwartz became aware of the abandoned status of the '365 application; that fact is inferred from his preparing a "substitute application" for Lonardo's execution in May 1975. Upon learning that the '365 application had become abandoned, Schwartz should have taken steps to revive the application; he should have known that the substitute application would not be entitled to the benefit of the '365 application's filing date. For the entire period from when he first learned of the abandoned status of the '365 application to his death in December 31, 1980, Schwartz made no attempt to revive the '365 application; he was less than diligent in that regard.

Not charging Schwartz's failure to revive the application to Lonardo

It is an established principle that the neglect or exercise of judgment of an attorney is chargeable to his client, and thus the client would have to suffer the consequences of his attorney's conduct. The rationale, as articulated in *Link v. Wabash R.R.*, 370 U.S. 626, 633-34 (1962), is that because the client voluntarily chose his own representative, he cannot seek to avoid the consequences or acts of this freely selected agent. The Court stated, *id.* at 634 n. 10, that if the attorney's conduct falls substantially below what is reasonable under the circumstances, the client's remedy is a malpractice suit against the attorney.

*5 In *Link*, the district court notified counsel for each side of the scheduling of a pretrial conference on October 12, 1960, at 1 p.m. On the morning of the scheduled date, plaintiff's counsel telephoned the courthouse for the judge, and was informed that the judge was on the bench. Plaintiff's counsel then left this message for the judge:

"that he [counsel] was busy preparing papers to file with the [Indiana] Supreme Court," that "he wasn't actually engaged in argument and that he couldn't be here by 1:00 o'clock, but he would be here either Thursday afternoon [October 13] or any time Friday [October 14] if it [the pretrial conference] could be reset."

Id. at 628. After plaintiff's counsel failed to attend the pretrial conference, the district court, upon review of the history of the case, dismissed the action for counsel's failure to appear for pretrial conference and for failure to prosecute. The Court of Appeals affirmed the district court. The Supreme Court in *Link* recognized that the review in that case involved the propriety of the district court's dismissal of the action under Federal Rules of Civil Procedure 41(b), 370 U.S. at 630, and not any refusal by the district court to grant plaintiff's request for relief from judgment under Rule 60(b). In particular, the Court stated: "[p]etitioner never sought to avail himself of the escape hatch provided by Rule 60(b)." *id.* at 632, and expressly left open the question whether the district court would have abused its discretion had it rejected a motion under Rule 60(b). *Id.* at 635.

In the context of relief from judgment under Rule 60(b), some courts have not broadly applied *Link*'s rule that an attorney's conduct is chargeable to his client, when the conduct is deemed to involve gross-negligence rather than ordinary neglect, e.g., *Boughner v. Secretary of Health, Education and Welfare*, 572 F.2d 976, 978 (3rd Cir.1978); *L.P. Steuart, Inc., v. Matthews*, 329 F.2d 234, 235 (D.C.Cir.1964), cert. denied, 379 U.S. 824 (1964), or simply when a default judgment is due to counsel's neglect. *Jackson v. Beech*, 636 F.2d 831, 837 (D.C.Cir.1980); see also *Carter v. Albert Einstein Medical Center*, 804 F.2d 805 (3rd Cir.1986) (vacating default judgment upon review of denial of relief under Rule 60(b), without classifying counsel's negligence as either ordinary or gross). Lonardo has not identified any decision of the Commissioner which distinguished gross-negligence from ordinary neglect when deciding whether to charge the conduct of an applicant's attorney to the applicant. But whether such a distinction is proper need not be decided here, because we cannot charge Schwartz's conduct to Lonardo for a different reason, i.e., attorney's intentional deception of his client.

*6 When an attorney intentionally conceals a mistake he has made, thus depriving the client of a viable

opportunity to cure the consequences of the attorney's error, the situation is not governed by the stated rule in Link for charging the attorney's mistake to his client. See *Jackson v. Washington Monthly Co.*, 569 F.2d 119, 122 n. 18 (D.C.Cir.1977):

The gross-neglect rule of *L.P. Steuart* has been criticized as discordant with Link. 7 J. Moore, *Federal Practice* ¶ 60.27[2], at 369-370 n. 47 (2d ed.1975); see *United States v. Cirami*, 535 F.2d 736, 740-741 (2d Cir.1976). But even if that were so, an attorney's deception of a blameless client would survive as a basis for relief under Rule 60(b)(6). See 7 J. Moore, *supra*, ¶ 60.27[2], at 368 n. 44. When a client does not knowingly and freely acquiesce in his attorney's neglectful conduct, but instead is misled into believing that the attorney is industrious, dismissal is not only a harsh step but one for which the circumstances provide little support for an agency theory as a rationale. Cf. *Thane Lumber Co. v. J.L. Metz Furniture Co.*, 12 F.2d 701, 703 (8th Cir.1926); *Chamberlain v. Amalgamated Sugar Co.*, 42 Idaho 604, 247 P. 12, 14 (1926).

United States v. Cirami, 563 F.2d 26 (2d Cir.1977), involved a situation in which the district court's denial of relief under Rule 60(b)(6) was reversed on the basis that the attorney's failure leading to dismissal of the action was demonstrated to be due to mental illness. That decision has been broadly interpreted by at least one district court as representing the view that any counsel's conduct of more than ordinary neglect or gross-negligence should not be charged to his client in the context of a request for relief under Federal Rules of Civil Procedure Rule 60(b)(6). As stated in *DeBonavena v. Conforte*, 88 F.R.D. 710, 712-13 (D.Nev.1981):

This Court views the legal propositions set forth in the *Cirami* cases as not necessarily limiting relief to those cases where there is mental illness. It seems that the philosophical basis of *Cirami* is somewhat broader. The essential question in the view of this Court is whether counsel's inaction was due to something more than negligence or neglect.

Sometime between April 15, 1974 and May of 1975, Schwartz must have learned that the '365 application had gone abandoned, because he prepared an identical substitute application and sent it to Lonardo in May 1975, to be executed, and filed the substitute application on June 6, 1975. The only reasonable inference which can be drawn from that circumstance is that Schwartz was aware the '365 application had become abandoned. Furthermore, at no time did he inform Lonardo of the abandoned status of the '365 application, despite Mrs. Lonardo's inquiries about the status of the application. On this record, it is reasonable to conclude that Schwartz knowingly concealed the abandonment of the '365 application from Lonardo, and covered up the abandonment by filing and prosecuting the substitute application as though it were the '365 application. His efforts in concealment were so successful that no one discovered the abandonment of the '365 application until more than fourteen years later in an infringement suit involving the patent which issued from the substitute application.

¶7 For the foregoing reasons, Schwartz's non-diligence in failing to have the abandoned application revived cannot be charged to Lonardo.

Initial abandonment was due to Schwartz's illness

This case involves factual circumstance which existed in early 1974, in the two months immediately preceding March 8, 1974, in which Schwartz should have filed a response in the '365 application. Sixteen years have passed since 1974, and much evidence which could have been available at that time are not available today. Nevertheless, the record can support a finding that Schwartz's ability to perform his responsibilities as a patent attorney was impaired during the period in question. Though the record might also support a contrary finding, that contrary finding is less plausible. Rather, Schwartz's health was so precarious after April 1973 that his failure to file a response in the '365 application between January 7, 1974, and March 7, 1974, was due at least in part to illness. Consequently, his lack of diligence in failing to respond to the office action is excused within the meaning of unavoidable delay under 35 U.S.C. § 133.

In 1973, Dr. Ezra Sharp had been Schwartz's treating physician for many years. According to Dr. Sharp's testimony, Schwartz considered himself well-versed in medicine, and rarely sought professional medical advice because he often made his own diagnosis and treated himself. Dr. Sharp testified that when Schwartz had his first heart problem, Schwartz even refused to go to the hospital and had to be treated at home as a result of which Dr. Sharp was deprived of opportunities to administer follow-up treatment.

Based on Dr. Sharp's testimony, we find that Schwartz was not an ordinary person insofar as the need to obtain professional medical assistance is concerned. For instance, he apparently was not likely to accept medical assistance until he had exhausted all means he thought were appropriate to treat himself. Consequently, whenever Schwartz would seek professional assistance, he was likely to have needed that professional medical attention at a much earlier time. Similarly, since he was not treated or seen by a physician, he might well have been seriously ill and needed to be hospitalized. Schwartz's regard (or lack thereof) for professional medical care was not ordinary.

Dr. Sharp testified that he saw Schwartz as a patient on April 9, 1973, at which time an EKG revealed evidence of a Myocardial Infarct which had resulted from a heart problem from 20 years ago. Thus, we know that Schwartz's heart condition had a tendency to grow progressively worse. Also, Schwartz's state of

health in April 1973 must have been extremely bad, because if not, he was unlikely to have sought professional medical attention. More importantly, because April 1973 was the last time Dr. Sharp saw Schwartz, Schwartz did not receive any professional follow-up treatment from Dr. Sharp; and there is no evidence of record that Schwartz received professional follow-up medical attention from any other physician. Presumably, after April 1973 and until his death in 1980, Schwartz was acting as his own doctor, attempting cures by whatever means he considered appropriate. Based in part on the following six factors, Schwartz's state of health from April 1973 to when he died in 1980 at approximately 81 years of age was extremely precarious:

- *8 (1) Schwartz's serious health condition in April 1973;
- (2) Schwartz's heart problem which worsened over time;
- (3) Lack of professional follow-up treatment after Dr. Sharp last saw Schwartz in April 1973;
- (4) Schwartz's general reluctance to seek professional medical attention;
- (5) Schwartz's tendency to make his own diagnosis and to treat himself;
- (6) Schwartz's advanced age.

In addition, Schwartz's precarious state of health undermined his abilities to fulfill responsibilities as a patent attorney. Other evidence directed to Schwartz's state of health of record before the PTO is not to the contrary. Schwartz himself told Mrs. Leonardo in the March 24, 1974, telephone conversation that he had been ill and he had neglect his work. Mrs. Leonardo heard in 1974 from another attorney in Rhode Island, Elliot Salter, that Schwartz had been ill "for sometime." Leonard Michaelson, also an attorney in Rhode Island, testified that Schwartz had had a heart attack ten years or so before his death.

Based on the findings above, one would anticipate that if Schwartz continued his patent practice following April 1973, he would begin to fail in his professional duties, and that such failures will become more numerous as time went on. Indeed, the facts discussed below are in accordance with that anticipation. In particular, with regard to nine filed applications including the '365 application, Schwartz failed in his responsibilities once in 1974, once in 1976, once in 1977, once in 1978, thrice in 1979, and twice in 1980.

The prosecution history of seven other applications prosecuted by Schwartz from the period of June 1976 to December 1980, are relevant. Those applications, in chronological order of the filing date, are:

Serial No.	Filing Date	Patent No.
1. ****	****	(not issued)
2. 696,486	06/15/76	4,378,948
3. 852,082	11/16/77	4,356,793
4. ****	****	(not issued)
5. D-949,812	10/10/78	D.269,300
6. D-949,813	10/10/78	D.268,619
7. D-19,460	03/12/79	4,545,378

Each of the above-identified seven applications became abandoned sometime during prosecution as a result of Schwartz's failure either to respond at all or to respond timely to an office action. Applications 1 and 4 above are not specifically identified because they have not issued as United States patents and thus have confidential status under 35 U.S.C. § 122. Schwartz refiled applications 3, 5, and 6 in December 1980, even though there were intervening sales in at least application 3.

*9 Application 1 became abandoned because Schwartz did not respond to an office action dated October 21, 1977, for which a response was due on December 21, 1977. Application 2 became abandoned because Schwartz did not respond to an office action dated September 22, 1976, for which a response was due on December 22, 1976. Application 3 became abandoned because Schwartz did not respond to an office action dated September 26, 1978, for which a response was due on December 26, 1978. Application 4 became abandoned because Schwartz did not respond to an office action dated March 27, 1980, for which a response was due on June 27, 1980. Application 5 became abandoned because Schwartz did not respond to an office action dated July 25, 1979, for which a response was due on August 25, 1979. Application 6 became abandoned because Schwartz did not respond to an office action dated June 4, 1979, for which a response was due on July 5, 1979. Application 7 became abandoned because Schwartz filed a response on January 28, 1980, to an office action dated October 25, 1979, for which a response was due on January 25, 1980.

An eighth application prosecuted by Schwartz, serial number 912,385, filed on June 5, 1978, also became abandoned as a result of Schwartz's failing to respond to an office action dated October 25, 1978, for which a response was due on January 25, 1979. Schwartz succeeded in reviving the abandoned application under Rule 137 on the basis of a mistake in docketing the office action for response; his petition to revive the application was granted on November 28, 1979. That application is now issued as United States Patent No. 4,211,190.

After Schwartz's death, petitions were filed in each of the above-listed seven applications to have them revived. The respective petitions were followed by a consolidated petition for revival of all seven applications. In all applications except for applications 2 and 5, the initial petitions had already been

denied when the consolidated petition was filed. Subsequent to the filing of the consolidated petition in each application, the petitions were granted and each application was revived. In each decision granting respective petitions, the PTO attributed Schwartz's failure to respond timely to his "inability to perform his responsibilities."

The seven applications were revived mainly on the basis of the consolidated petition, which included (1) a declaration of Dr. Ezra A. Sharp; and (2) a declaration of Herbert Barlow, a patent attorney who took over several of Schwartz's on-going patent matters after Schwartz's death. Incidentally, it is noted that the consolidated petition misstated the filing date of application 1 as January 21, 1978, of application 2 as December 22, 1976, and of application 7 as January 25, 1980.

In addition to Dr. Sharp's testimony already discussed above, Dr. Sharp stated:

In recent years I have had no doctor-patient relationship with Max Schwartz that would enable me to provide a professional opinion as to his mental deterioration in recent years. However, his senility would not be inconsistent with my prior observations of him during those occasions when I was called upon to treat his heart problems.

*10 Mr. Barlow stated that his law firm assumed the prosecution of a number of patent applications which were formerly handled by Schwartz. His testimony recounted three instances in which Schwartz had not filed completed United States patent applications which should have been filed, and nine instances in which Schwartz caused erroneously instructed foreign associates to drop the prosecution of corresponding foreign applications. Mr. Barlow stated that the foreign applications were filed "in the fall and early spring of 1978- 79." He also stated that one of the three unfilled United States patent applications included a signed declaration dated September of 1979; no dates for the other two unfilled United States applications were noted.

As evidenced above, Schwartz's course of professional failures subsequent to April 1973 was progressively worse. The failures began in early 1974 and became more frequent in the following years. Because Schwartz's state of health became precarious as early as April 1973, there is no reason to isolate the year 1974 and treat it differently from the later years. Accordingly, the initial abandonment of the '365 application was due at least in part to Schwartz's illness and thus excused within the meaning of unavoidable delay under 35 U.S.C. § 133. See e.g. In re Mattullath, 1912 Dec.Comm'r Pat. 490, 493 (App.D.C.1912); Ex parte Sellers, 1905 Dec.Comm'r Pat. 336 (Comm'r Pat.1905); McDuffee v. Hestonville, 181 F. 503, 510-11 (E.D.Pa.1910).

Conclusion

For the foregoing reasons and on this rather unusual set of facts, Lonardo has demonstrated unavoidable delay within the meaning of 35 U.S.C. § 133, and the renewed petition under 37 CFR § 1.137(a) to revive the '365 application from abandonment is granted.

17 U.S.P.Q.2d 1455

END OF DOCUMENT

EXHIBIT 4

USPTO Registration Information Webpage regarding William F. Prendergast

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Last Name	Prendergast
First Name	William
Middle Name	F
Suffix	
Firm Name	Brinks Hofer Gilson and Lione
Address	455 N Cityfront Plaza Dr Ste 3600
City	Chicago
State/Province	IL
Postal Code	60611
Country	US
Primary Telephone	(312) 321-4200
Registration Number	34699
Attorney/Agent	ATTORNEY
Date Registered as Attorney	04/15/1991

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EXHIBIT 5

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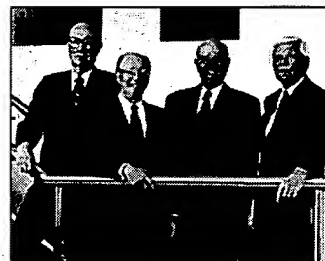
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Firm History

Introduction

Brinks Hofer Gilson & Lione was founded in 1917 as the two-man patent law firm of Wilkinson & Huxley. Today Brinks has approximately 150 attorneys, supported by a full complement of scientific advisors, patent agents and paralegals. Our headquarters are atop Chicago's preeminent NBC Tower.



Left to Right: Henry Brinks, Roy Hofer, Jerome Gilson and Richard Lione

Practice Spectrum

As one of the largest firms in its specialty, Brinks is at the cutting edge of intellectual property law.

We litigate, counsel and prosecute in patent, trademark, copyright, trade secret, unfair competition, Internet and related areas of law. We routinely handle assignments in fields as diverse as electrical, chemical, mechanical, biotechnology, pharmaceutical, nanotechnology and computer technology, as well as in trademarks or brand names for a wide variety of products and services.

Brinks also takes civic pride in providing pro bono legal services to those unable to pay in matters involving eviction, immigration, asylum and criminal matters, as well as non-profits in their intellectual property law matters.

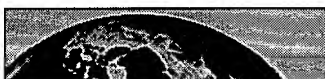
Historical

With more than 90 years of practice experience, the firm has become rich in the history and development of intellectual property law and in the professional associations that serve it. Its members have handled landmark cases before the United States Supreme Court and the regional Courts of Appeals and have held leadership positions in all the major bar and intellectual property law associations.

Founder George Wilkinson argued and won the case in which Justice Frankfurter introduced the term "commercial magnetism" (the quality that entitles a symbol to protection) into the lexicon of trademark law. In 1930, founder Henry Huxley not only handled an active legal practice, but also taught a course in patent law at Northwestern University Law School. Both Wilkinson and Huxley rose to prominence in the American Bar Association's Patent, Trademark and Copyright section.

James Hume, a prominent partner in the firm from 1947 to 1983, tried patent cases across the country, and at one point, flew with Charles Lindbergh, then a Postal Service pilot. He also gave patent counsel to research scientists Leo Szilard and Enrico Fermi in connection with their work on the Manhattan Project, a former U.S. executive agency that was responsible for developing the atomic bomb.

Howard Clement, another named partner from 1956-1983, litigated major patent cases, served as President of the University of Illinois Board of Trustees and contributed substantively as a member of President Lyndon Johnson's commission to recommend revisions to the U.S. Patent System.



Firm Leadership

Gary Ropski's professional and leadership skills led his



partners to name him the President of the firm in 2006. His broad legal experience cuts across the entire spectrum of intellectual property law, with more than 100 disputes litigated before the International Trade Commission and in every federal circuit in the country. His trial skills served him well as an adjunct professor at Northwestern Law School for almost two decades, and his writing awards attest to his command of the language. Gary has played an active role in his firm, his profession and in his community.

The mission statement of Jerold Jacover, President from 2000-2005, still guides our firm: "We provide premium intellectual property law services, in an appropriate environment, in an ethical and professional manner."

Firm Practice Groups

Brinks is organized in both practice area and industry groups, ranging from Biotechnology/Pharmaceutical to Appellate Practice to Trademark. Each group monitors and implements practice changes required by current developments in its area.

The groups are led by a generation of highly talented lawyers who have substantial experience handling first chair and comparable non-litigation responsibilities. To them and their members, and to the firm's senior leadership as well, go the credit for the firm being ranked over the last several years by various publications as #1 in intellectual property law in Chicago, #1 in Illinois, and #1 in the U.S. Central Region, frequently through peer surveys.

Jury Trial Record

The firm is justifiably proud of its pioneering successes in trying intellectual property law cases to juries. Defying the notion that juries cannot understand highly technical subject matter, its lawyers have generated noteworthy awards, many of them in the last decade.

In what became the largest jury award in firm history, Roy Hofer led a trial team in a Chicago case involving patents relating to plastic films for packaging meats. After a 13-day trial the judge and jury found all patents valid and infringed, and ultimately, the judge entered judgment of \$164,925,789 for our client.

In other firm jury cases, awards obtained include \$40 million for infringing patents covering fan assemblies used with radiators and condensers in automobiles and \$12.5 million for infringement of a patent for an outdoor electrical outlet cover.

In 2004, juries awarded firm clients \$3.5 million in a gray market trademark infringement case, \$5.9 million for infringement of a patent for automatically inflating, adjustable air mattresses, and \$1 million for trademark infringement, plus attorneys' fees.

Today's Name Partners

Henry Brinks, Roy Hofer, Jerome Gilson and Richard Lione remain active in the firm, having together amassed more than 175 years of service to the firm, its clients and to civic and professional associations.

Henry Brinks has been a stalwart in patent law and litigation for a half century, handling numerous trials and patent counseling for high profile clients and participating in a dozen intellectual property law and other associations.

Known in the firm as "the Coach," Roy Hofer is an experienced patent litigator with a national reputation. He has written and lectured widely, and also has served as President of the Chicago Bar Association, the Federal Circuit Bar Association and the Center for Conflict Resolution.

Jerome Gilson is a distinguished trademark lawyer, who authored and who currently supplements the 30-year old leading treatise, *Trademark Protection and Practice* (LexisNexis/Matthew Bender). In 1998 he was named by his peers as "Top Trademark Practitioner in the World" in a survey conducted by the U.K. publication *Managing Intellectual Property*.

Richard Lione's career has been a unique blend of patent prosecution and litigation, two skill sets that today rarely overlap. He has also achieved distinction in spending about half of his

time representing major European and Japanese businesses, in diverse technologies such as robotics, machine tools, aircraft instrumentation, textiles and packaging machinery.

Conclusion

Since 1917, Brinks Hofer Gilson & Lione has earned an enviable reputation. Through the stellar efforts of our lawyers in trying cases, arguing appeals, writing books, heading associations, teaching law school courses and handling pro bono matters, the firm will continue to serve its clients, the legal profession and the public with distinction.

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EXHIBIT 6

Redacted Brinks Hofer Gilson and Lione WFP Investigation Status Report

	Investigation Status	Client No.	Client Name	Client Matter No.	Matter Status	Summary
1.	Issues	1	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon, Fabricated Documents, False Statements-Written, False Statements-Oral
2.	Issues	2	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon, Fabricated Documents, False Statements-Written
3.	Issues	2	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon, Fabricated Documents, False Statements-Written, False Statements-Oral
4.	Issues	3	[REDACTED]	[REDACTED]	Pending	Authority to abandon, Fabricated Documents, False Statements-Written
5.	Issues	3	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon, Fabricated Documents, False Statements-Written, False Statements-Oral
6.	Issues	4	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon, Fabricated Documents, False Statements-Written
7.	Issues	5	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon, False Statements-Written
8.	Issues	5	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon, False Statements-Written
9.	Issues	5	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon
10.	Issues	5	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon, False Statements-Written
11.	Issues	5	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon, False Statements-Written
12.	Issues	7	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon, False Statements-Written

WFP Investigation Status Report 10-15-08 (Redacted)

Sorted by Investigation Status (descending), Client No. and Client Matter No. (ascending)

	Investigation Status	Client No	Client Name	Client Matter No	Matter Status	Summary
13.	Issues	7	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon, False Statements-Written
14.	Issues	7	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon, False Statements-Written
15.	Issues	7	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon, False Statements-Written
16.	Issues	7	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon, False Statements-Written
17.	Issues	11	[REDACTED]	[REDACTED]	Issued	Fabricated Documents, False Statements-Written, False Statements-Oral
18.	Issues	11	[REDACTED]	[REDACTED]	Pending	Fabricated Documents, False Statements-Written, False Statements-Oral
19.	Issues	11	[REDACTED]	[REDACTED]	Pending	Fabricated Documents, False Statements-Written, False Statements-Oral
20.	Issues	11	[REDACTED]	[REDACTED]	Pending	Fabricated Documents, False Statements-Written, False Statements-Oral
21.	Issues	11	[REDACTED]	[REDACTED]	Pending	False Statements-Written
22.	Issues	12	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon, Fabricated Documents, False Statements-Written
23.	Issues	12	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon, Fabricated Documents, False Statements-Written
24.	Issues	15	[REDACTED]	[REDACTED]	Issued	Authority to abandon, Fabricated Documents, False Statements-Written
25.	Investigating	2	[REDACTED]	[REDACTED]	Issued	

	Investigation Status	Client No	Client Name	Client Matter No	Matter Status	Summary
26.	Investigating	2			Abandoned	Authority to abandon
27.	Investigating	2			Abandoned	Authority to abandon
28.	Investigating	2			Issued	Renewal fees
29.	Investigating	2			Unfiled	Foreign filings
30.	Investigating	2			Expired	Renewal fees
31.	Investigating	2			Lapsed	Renewal fees
32.	Investigating	2				
33.	Investigating	2			Unfiled	
34.	Investigating	3			Abandoned	Authority to abandon
35.	Investigating	3			Abandoned	Authority to abandon
36.	Investigating	3			Abandoned	Authority to abandon
37.	Investigating	3			Abandoned	Authority to abandon
38.	Investigating	3			Abandoned	Authority to abandon
39.	Investigating	3			Unfiled	Authority to abandon
40.	Investigating	3			Abandoned	Authority to abandon
41.	Investigating	3			Abandoned	Authority to abandon
42.	Investigating	3			Abandoned	Authority to abandon
43.	Investigating	3			Abandoned	Authority to abandon
44.	Investigating	3				
45.	Investigating	3			Abandoned	Authority to abandon
46.	Investigating	3			Abandoned	Authority to abandon
47.	Investigating	3			Abandoned	Authority to abandon

WFP Investigation Status Report 10-15-08 (Redacted)

Sorted by Investigation Status (descending), Client No. and Client Matter No. (ascending)

	Investigation Status	Client No	Client Name	Client Matter No	Matter Status	Summary
48.	Investigating	3			Abandoned	Authority to abandon
49.	Investigating	3			Abandoned	Authority to abandon
50.	Investigating	3			Abandoned	Authority to abandon
51.	Investigating	3			Abandoned	Authority to abandon
52.	Investigating	3			Abandoned	Authority to abandon
53.	Investigating	3			Abandoned	Authority to abandon
54.	Investigating	3			Abandoned	Authority to abandon
55.	Investigating	3			Abandoned	Authority to abandon
56.	Investigating	4			Abandoned	Authority to abandon
57.	Investigating	4			Abandoned	Authority to abandon
58.	Investigating	5			Abandoned	Authority to abandon
59.	Investigating	5			Abandoned	Authority to abandon
60.	Investigating	5			Abandoned	Authority to abandon
61.	Investigating	5			Abandoned	Authority to abandon
62.	Investigating	5			Abandoned	Authority to abandon
63.	Investigating	5			Abandoned	Authority to abandon
64.	Investigating	5			Abandoned	Authority to abandon
65.	Investigating	5			Abandoned	Authority to abandon
66.	Investigating	5			Abandoned	Authority to abandon
67.	Investigating	5			Abandoned	Authority to abandon
68.	Investigating	5			Issued	False Statements-Written
69.	Investigating	5			Abandoned	Authority to abandon

WFP Investigation Status Report 10-15-08 (Redacted)

Sorted by Investigation Status (descending), Client No. and Client Matter No. (ascending)

	Investigation Status	Client No.	Client Name	Client Matter No.	Matter Status	Summary
70.	Investigating	6	[REDACTED]	[REDACTED]	Issued	
71.	Investigating	6	[REDACTED]	[REDACTED]	Abandoned	
72.	Investigating	6	[REDACTED]	[REDACTED]	Abandoned	
73.	Investigating	7	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon
74.	Investigating	7	[REDACTED]	[REDACTED]	Pending	Authority to abandon
75.	Investigating	7	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon
76.	Investigating	7	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon
77.	Investigating	7	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon
78.	Investigating	8	[REDACTED]	[REDACTED]	Pending	Authority to abandon
79.	Investigating	9	[REDACTED]	[REDACTED]		
80.	Investigating	10	[REDACTED]	[REDACTED]	Issued	
81.	Investigating	10	[REDACTED]	[REDACTED]	Abandoned	
82.	Investigating	12	[REDACTED]	[REDACTED]		Authority to abandon
83.	Investigating	12	[REDACTED]	[REDACTED]	Abandoned	Authority to abandon
84.	Investigating	13	[REDACTED]	[REDACTED]		
85.	Investigating	14	[REDACTED]	[REDACTED]		
86.	Investigating	14	[REDACTED]	[REDACTED]		

EXHIBIT 7

**Apparently Falsified Petition for Withdrawal of the Erroneous Holding of
Abandonment and Return Post Card**

Case No.
Applicant

8285/153
Connolly et al.

Hon. Commissioner of Patents & Trademarks
Washington, D.C. 20231

Please acknowledge receipt of the below-identified:

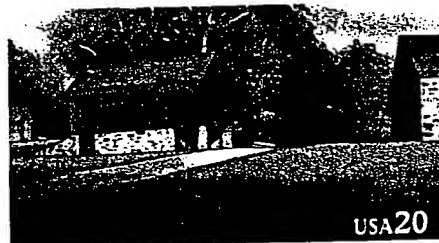
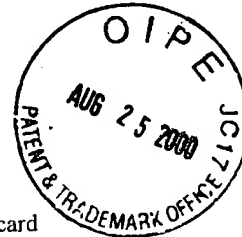
Serial No: 08/926,187

Petition To Withdraw Erroneous Abandonment; Return Postcard

BRINKS HOFER GILSON & LIONE

By: W. F. Prendergast/mal

Date of Mailing: August 22, 2000



BRINKS HOFER GILSON & LIONE

A PROFESSIONAL CORPORATION

P. O. BOX 10395

CHICAGO, ILLINOIS 60610

TRANSMITTAL LETTER			Case No. 8285/153
Serial No. 08/926,187	Filing Date 09/09/97	Examiner Trost	Group Art Unit 2744
Inventor(s) David A. Connolly			
Title of Invention Wireless Digital Personal Communications System			

TO THE COMMISSIONER FOR PATENTS

Transmitted herewith is Petition For The Withdrawal Of The Erroneous Holding Of Abandonment (2): Return Post Card.

- ☐ Small entity status of this application under 37 CFR § 1.27 has been established by verified statement previously submitted.
- ☐ Applicant claims small entity status. See 37 CFR 1.27.
- ☐ Petition for a _____ month extension of time.
- ☐ No additional fee is required.
- ☐ The fee has been calculated as shown below:


	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra
Total		Minus		
Indep.		Minus		
First Presentation of Multiple Dep. Claim				

Small Entity	
Rate	Add'l Fee
x \$9 =	
x 42 =	
+ \$140 =	
Total add'l fee	\$

Other Than Small Entity	
Rate	Add'l Fee
x \$18 =	
x \$84 =	
+ \$280 =	
Total add'l fee	\$

- ☐ Please charge Deposit Account No. 23-1925 (BRINKS HOFER GILSON & LIONE) in the amount of \$_____. A duplicate copy of this sheet is enclosed.
- ☐ A check in the amount of \$_____ to cover the filing fee is enclosed.
- ☒ The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this communication or credit any overpayment to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.
- ☒ I hereby petition under 37 CFR § 1.136(a) for any extension of time required to ensure that this paper is timely filed. Please charge any associated fees which have not otherwise been paid to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.

Respectfully submitted,


 William F. Prendergast
 Registration No. 34,699
 Attorney for Applicant

BRINKS HOFER GILSON & LIONE
 P.O. BOX 10395
 CHICAGO, ILLINOIS 60610
 (312) 321-4200

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on 8/22/02

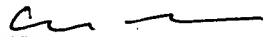
Date: 8/22/02 Signature: 

Applicants have received a Notice of Abandonment for the above-identified application. The Notice of Abandonment indicates that the applicants did not respond to the Notice of Allowance that was mailed July 15, 1999. In response to the Notice of Allowance, Applicants paid the issue fee on October 15, 1999 using the "Certificate of Mailing Procedure" under 37 C.F.R. § 1.8. (The "Certificate of Mailing" stamp was signed by William F. Prendergast, Registration No. 34,699). Enclosed with this Petition is a copy of issue fee transmittal and a copy of the stamped-received return postcard.

Therefore, Applicants respectfully petition the Commissioner to withdraw the Holding of Abandonment for the application.

The Commissioner is hereby authorized to charge payment of any fees associated with this Petition of Withdrawal to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.

Respectfully submitted,



William F. Prendergast
Registration No. 34,699
Attorney for Applicant

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
David A. Connolly et al.)	
)	
Serial No. 08/926,187)	Examiner Trost
)	
Filing Date: September 9, 1997)	Group Art Unit 2744
)	
For Wireless Digital Personal)	
Communications System)	
)	


DECLARATION OF WILLIAM F. PRENDERGAST

The undersigned hereby states as follows:

1. A Notice of Abandonment was mailed June 22, 2000 stating that Issue Fee Transmittal was never received by the United States Patent and Trademark Office.
2. Applicant mailed the Issued Fee Transmittal on October 15, 2000 using the Certificate of Mailing Procedure.
3. Attached hereto as Exhibit A is the Issue Fee Transmittal and stamped postcard acknowledging receipt by the United States Patent Office.
4. I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge and belief.

Date:

8/22/00



William F. Prendergast

TRANSMITTAL LETTER			Case No. 8285/153
Serial No. 08/926,187	Filing Date: 09/09/97	Examiner Trost	Group Art Unit 2744
Inventor(s) Connolly et al.			
Title of Invention Wireless Digital Personal Communications System			

TO THE ASSISTANT COMMISSIONER FOR PATENTS

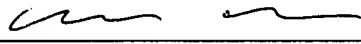
Transmitted herewith is PTOL-85B (dupl.); Return Post Card.

- ☐ Small entity status of this application under 37 CFR § 1.27 has been established by verified statement previously submitted.
- ☐ A verified statement to establish small entity status under 37 CFR §§ 1.9 and 1.27 is enclosed.
- ☐ Petition for a _____ month extension of time.
- ☒ No additional fee is required.
- ☐ The fee has been calculated as shown below:

				Small Entity		or	Other Than Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	Rate	Add'l Fee
Total		Minus			x \$9 =		x \$18 =	
Indep.		Minus			x 39 =		x \$78 =	
First Presentation of Multiple Dep. Claim					+ \$130 =		+ \$260 =	
					Total add'l fee	\$	total add'l fee	\$

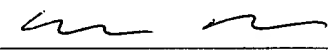
- ☒ Please charge Deposit Account No. 23-1925 (BRINKS HOFER GILSON & LIONE) in the amount of \$ 1340. A duplicate copy of this sheet is enclosed.
- ☐ A check in the amount of \$ to cover the filing fee is enclosed.
- ☒ The Assistant Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this communication or credit any overpayment to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.
- ☒ I hereby petition under 37 CFR § 1.136(a) for any extension of time required to ensure that this paper is timely filed. Please charge any associated fees which have not otherwise been paid to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.

Respectfully submitted,


 William F. Prendergast
 Registration No. 34,699
 Attorney for Applicant

BRINKS HOFER GILSON & LIONE
 P.O. BOX 10395
 CHICAGO, ILLINOIS 60610
 (312) 321-4200

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on October 15, 1999.

Date: 10/15/99 Signature: 

Case No. 8285/153
Applicant Connolly et al.

Hon. Commissioner of Patents & Trademarks
Washington, D.C. 20231

Please acknowledge receipt of the below-identified:

Serial No: 08/926,187

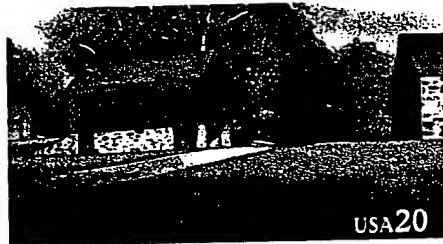
PTOL-85b (DUPL.), Issue Fee 1340, Return Post Card

BRINKS HOFER GILSON & LIONE

By: W. F. Prendergast/mal

Date of Mailing: October 15, 1999

RECEIVED
NOV -5 1999
TECH CENTER 2700



BRINKS HOFER GILSON & LIONE

A PROFESSIONAL CORPORATION

P. O. BOX 10395

CHICAGO, ILLINOIS 60610

PART B—ISSUE FEE TRANSMITTAL

Complete and mail this form, together with applicable fees, to:

Box ISSUE FEE
Assistant Commissioner for Patents
Washington, D.C. 20231

MAILING INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE. Blocks 1 through 4 should be completed where appropriate. All further correspondence including the Issue Fee Receipt, the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Legibly mark-up with any corrections or use Block 1)

LM41/0715
WILLIAM F. PRENDERGAST
BRINKS HOFER GILSON & LIONE
PO BOX 10395
CHICAGO IL 60610

Note: The certificate of mailing below can only be used for domestic mailings of the Issue Fee Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing.

Certificate of Mailing

I hereby certify that this Issue Fee Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Box Issue Fee address above on the date indicated below.

William Prendergast

(Depositor's name)

(Signature)

10/15/99

(Date)

APPLICATION NO.	FILING DATE	TOTAL CLAIMS	EXAMINER AND GROUP ART UNIT	DATE MAILED
08/926,187	09/09/97	027	TROST IV, W.	2744 07/15/99
First Named Applicant: CONNOLLY, DAVID A.				

TITLE OF INVENTION: WIRELESS DIGITAL PERSONAL COMMUNICATIONS SYSTEM HAVING VOICE/DATA/IMAGE TWO-WAY CALLING AND INTERCEL HAND-OFF

ATTY'S DOCKET NO.	CLASS-SUBCLASS	BATCH NO.	APPLN. TYPE	SMALL ENTITY	FEE DUE	DATE DUE
2 8285	455-461,000	V75	UTILITY	NO	\$1210.00	10/15/99

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363). Use of PTO form(s) and Customer Number are recommended, but not required.

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47) attached.

2. For printing on the patent front page, list (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1. Brinks Hofer
Gilson & Lione

2. _____

3. _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)
PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. Inclusion of assignee data is only appropriate when an assignment has been previously submitted to the PTO or is being submitted under separate cover. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE: Amecitech Corporation

(B) RESIDENCE: (CITY & STATE OR COUNTRY)

Hoffman Estates, IL

Please check the appropriate assignee category indicated below (will not be printed on the patent)

☐ individual ☒ corporation or other private group entity ☐ government

4a. The following fees are enclosed (make check payable to Commissioner of Patents and Trademarks):

☒ Issue Fee

☒ Advance Order - # of Copies 10

4b. The following fees or deficiency in these fees should be charged to:

DEPOSIT ACCOUNT NUMBER 23-1925
(ENCLOSE AN EXTRA COPY OF THIS FORM)

☒ Issue Fee

☒ Advance Order - # of Copies 10

The COMMISSIONER OF PATENTS AND TRADEMARKS IS requested to apply the Issue Fee to the application identified above.

(Authorized Signature)

(Date)

NOTE: The Issue Fee will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the Patent and Trademark Office.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending on the needs of the individual case. Any comments on the amount of time required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, D.C. 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND FEES AND THIS FORM TO: Box Issue Fee, Assistant Commissioner for Patents, Washington D.C. 20231

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMIT THIS FORM WITH FEE

EXHIBIT 8

**Selection of Redacted Electronic Mail Referencing Communications between
Mr. Prendergast and USPTO**

From: Prendergast, William
Sent: Monday, November 03, 2003 7:08 PM
To: Hetz, Joe
Subject: RE: [REDACTED]

Joe,
Sorry about the delay. I have a call into the Petitions Branch at the PTO. I was referred there by the Supervising Examiner. They promised to get back to me in the next few days. I will keep after them. Bill.

-----Original Message-----

From: Hetz, Joe
Sent: Monday, November 03, 2003 11:34 AM
To: Prendergast, William
Subject: RE: [REDACTED]

Bill,

I don't think I received your response to my email from last month.

Joe

-----Original Message-----

From: Hetz, Joe
Sent: Thursday, October 02, 2003 3:44 PM
To: Prendergast, William
Subject: [REDACTED]

Bill,

Please provide me with an update on the [REDACTED] matters.

Thanks,
Joe

-I assume you have the files, so can we meet in your office for your convenience? I am free all morning and also at 2 pm today. Please let me know what works best. Thanks. John.

-----Original Message-----

From: Hetz, Joe <jhetz@brinkshofer.com>
To: Prendergast, William <wprendergast@brinkshofer.com>
CC: Lucas, John <jlucas@brinkshofer.com>
Sent: Mon Jul 12 17:48:31 2004
Subject: RE: Docketing Update

Bill,

I didn't hear back from you today. Please let me know when I can expect your response. It is very important that we resolve these issues immediate.

Thanks,
Joe

-----Original Message-----

From: Hetz, Joe
Sent: Friday, July 09, 2004 10:15 AM
To: Prendergast, William
Cc: Lucas, John
Subject: RE: Docketing Update

Bill,

I haven't received your reply yet. Please update me on the remaining cases on the list.

Also, please update me on the following matters:

[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]

Docketing notes this as abandoned.
Docketing notes this as abandoned.
Docketing notes this as abandoned.
Docketing notes this as abandoned.

[REDACTED]

Docketing notes this as unfiled.

[REDACTED]

Docketing notes this as pending.

Also, did you file continuations based on (1) [REDACTED] and (2) [REDACTED]

Thanks,
Joe

-----Original Message-----

From: Hetz, Joe
Sent: Wednesday, July 07, 2004 12:11 PM
To: Prendergast, William
Cc: Lucas, John
Subject: RE: Docketing Update

Thanks Bill. Please send docketing an abandon/close memo for the cases that should be removed from the active docket. The memo can be found under the docket templates

-----Original Message-----

From: Prendergast, William
Sent: Tuesday, July 13, 2004 10:42 AM
To: Hetz, Joe; Lucas, John
Subject: RE: Docketing Update

Joe,

Following up on our conversation. As we have been instructed to close the remaining cases identified on your list, I will meet with Jesse today to have the docket updated. As to the [REDACTED] matters, I mentioned that I followed up with the PTO regarding [REDACTED]. I am advised by the Office Of Petitions that we can expect a response within the next three months. I updated the docket to indicate that a continuation should be filed by December of this year at the latest. I will review the remaining matters today. However, as I indicated, these are old cases we were probably instructed to drop and that were not subject to the continuation request of [REDACTED]. I'll attend to these matters today.

Let me know if we still need to meet. However, I have two client meetings this afternoon. I apologize for the delay in responding to you.
Bill

-----Original Message-----

From: Hetz, Joe
Sent: Tuesday, July 13, 2004 8:18 AM
To: Lucas, John; Prendergast, William
Subject: RE: Docketing Update

Let's meet at 2, which will be right after our call with [REDACTED].

-----Original Message-----

From: Lucas, John
Sent: Tuesday, July 13, 2004 6:30 AM
To: Hetz, Joe; Prendergast, William
Subject: Re: Docketing Update

Joe--I spoke with Bill about these cases, and he reassured me that everything has been taken care of. Nevertheless, I suggest that the three of us meet today and review the files. Bill--I assume you have the files, so can we meet in your office for your convenience? I am free all morning and also at 2 pm today. Please let me know what works best. Thanks. John.

-----Original Message-----

From: Hetz, Joe <jhetz@brinkshofer.com>
To: Prendergast, William <wprendergast@brinkshofer.com>
CC: Lucas, John <jlucas@brinkshofer.com>
Sent: Mon Jul 12 17:48:31 2004
Subject: RE: Docketing Update

Bill,

I didn't hear back from you today. Please let me know when I can expect your response. It is very important that we resolve these issues immediate.

Thanks,
Joe

-----Original Message-----

From: Prendergast, William
Sent: Thursday, October 07, 2004 4:04 PM
To: Hetz, Joe
Subject: RE: Docketing Update.

Joe,

I received a call from Examiner Day at the Patent Office. She stated that we can expect a response in approximately the next 1-2 months. I explained that we are interested in getting this matter resolved as quickly as possible. She indicated that she would try and speed things up, but that her matters must be resolved in order. She also apologized for the delay and inconvenience. I will update the client.
WFP

-----Original Message-----

From: Hetz, Joe
Sent: Thursday, October 07, 2004 3:28 PM
To: Prendergast, William
Subject: RE: Docketing Update

Any update on this?

-----Original Message-----

From: Prendergast, William
Sent: Monday, October 04, 2004 11:50 AM
To: Hetz, Joe
Subject: RE: Docketing Update

Joe,

The PTO promised an update no later than Wed. I will keep you informed. WFP

-----Original Message-----

From: Hetz, Joe
Sent: Wednesday, September 29, 2004 1:22 PM
To: Prendergast, William; Lucas, John
Subject: RE: Docketing Update

Bill,

Any update on [REDACTED] yet?

Thanks,
Joe

-----Original Message-----

From: Prendergast, William
Sent: Thursday, October 07, 2004 4:04 PM
To: Hetz, Joe
Subject: RE: Docketing Update

Joe,

I received a call from Examiner Day at the Patent Office. She stated that we can expect a response in approximately the next 1-2 months. I explained that we are interested in getting this matter resolved as quickly as possible. She indicated that she would try and speed things up, but that her matters must be resolved in order. She also apologized for the delay and inconvenience. I will update the client.

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-----Original Message-----

From: Hetz, Joe
Sent: Thursday, October 07, 2004 3:28 PM
To: Prendergast, William
Subject: RE: Docketing Update

Any update on this?

-----Original Message-----

From: Prendergast, William
Sent: Monday, October 04, 2004 11:50 AM
To: Hetz, Joe
Subject: RE: Docketing Update

Joe,

The PTO promised an update no later than Wed. I will keep you informed. WFP

-----Original Message-----

From: Hetz, Joe
Sent: Wednesday, September 29, 2004 1:22 PM
To: Prendergast, William; Lucas, John
Subject: RE: Docketing Update

Bill,

Any update on [REDACTED] yet?

Thanks,
Joe

From: Prendergast, William
Sent: Thursday, February 17, 2005 10:56 AM
To: Hetz, Joe
Subject: RE: [REDACTED] Update

Joe,
spoke with the paralegal that called previously. She said that everything was in order and the petition was sent for review by a staff attorney at the PTO. I have placed a call today with the staff attorney to see when we can expect an action. I have not heard back yet. I'll let you know when I get a return call.
WFP

-----Original Message-----
From: Hetz, Joe
Sent: Wednesday, February 16, 2005 1:14 PM
To: Prendergast, William
Subject: RE: [REDACTED] Update

Bill,

Can you give me an update on this?

Thanks,
Joe

-----Original Message-----
From: Prendergast, William
Sent: Wednesday, January 12, 2005 8:15 AM
To: Hetz, Joe
Subject: RE: [REDACTED] Update

I have not heard anything since my last message. I'll call for an update.
WFP

-----Original Message-----
From: Hetz, Joe
Sent: Tuesday, January 11, 2005 10:26 AM
To: Prendergast, William
Subject: RE: [REDACTED] Update

Bill,

Can you give me an update on this?

Thanks,
Joe

-----Original Message-----
From: Prendergast, William
Sent: Wednesday, December 01, 2004 9:06 AM

From: Prendergast, William
Sent: Monday, June 20, 2005 12:48 PM
To: Hetz, Joe
Subject: [REDACTED] Update

Joe,

I spoke with the PTO regarding the pending action for the [REDACTED] application. I was advised by the Petitions Branch that we can expect a response shortly.i.e., in the next month or two.
Bill

**BRINKS
HOFFER
GILSON
& LIONE**

**INTELLECTUAL
PROPERTY ATTORNEYS**

William F. Prendergast
455 N. Cityfront Plaza Dr.
Chicago, IL 60611
wfp@brinkshofer.com
312-321-4242 (phone)
312-321-4299 (fax)

From: Prendergast, William
Sent: Monday, October 03, 2005 3:55 PM
To: Hetz, Joe
Subject: RE:

Joe,
The last time I spoke with the PTO I was advised that we should have a response shortly. I will follow and request something in writing.
WFP

From: Hetz, Joe
Sent: Friday, September 30, 2005 10:54 AM
To: Prendergast, William
Subject: RE:

Bill,

Any update?

Thanks,
Joe

From: Prendergast, William
Sent: Wednesday, August 31, 2005 11:30 AM
To: Hetz, Joe
Subject: RE:

I will request an update.
WFP

Prendergast, William

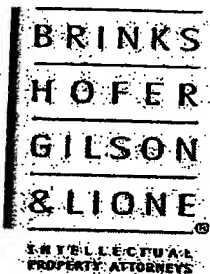
From: Prendergast, William
Sent: Friday, October 28, 2005 4:53 PM
To: Hetz, Joe
Subject: [REDACTED]

Joe,

Thanks for your message. I spoke with PTO earlier this week about this case. I am advised that we can expect a response to our petition to withdraw the erroneous abandonment shortly. They again apologized for the delay as the file was lost (and then reconstructed) and the petition also needed to be resubmitted. We should be able to advance this case in the near future. I will continue to follow up with the PTO on a regular basis. As soon as this issue is resolved, we plan to file a continuation with the approval of [REDACTED]. Could you let me know who I should contact in the absence of [REDACTED]?

Thanks.

Bill Prendergast



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wfp@brinkshofer.com
312-321-4242 (phone)
312-321-4299 (fax)

Prendergast, William

From: Prendergast, William
Sent: Tuesday, January 03, 2006 10:28 AM
To: Hetz, Joe
Subject: RE: [REDACTED]

Joe,

I was out last week for the Holiday. The last I heard we are in the que. I'll call for an update from the Examiner and ask for a more specific date. I will move up the chain if we don't get a satisfactory response. I'll keep you updated.
WFP

From: Hetz, Joe
Sent: Friday, December 23, 2005 10:35 AM
To: Prendergast, William
Subject: RE: [REDACTED]

Hi Bill,

Any word yet?

Thanks
Joe

From: Prendergast, William
Sent: Wednesday, November 30, 2005 8:49 AM
To: Hetz, Joe
Subject: RE: [REDACTED]

I'll get an update.
WFP

From: Hetz, Joe
Sent: Tuesday, November 29, 2005 4:40 PM
To: Prendergast, William
Subject: RE: [REDACTED]

Bill,

Any update on this?

Thanks,
Joe

From: Hetz, Joe
Sent: Monday, October 31, 2005 8:55 AM
To: Prendergast, William
Subject: RE: [REDACTED]

Thanks Bill. I forwarded the information along to [REDACTED]. The new contact is [REDACTED], but he has delegated all prosecution decisions to [REDACTED], a former Brinks attorney who is now one [REDACTED] outside counsel and works at [REDACTED].

on Thursdays. We have a dedicated office hour with [REDACTED] on Thursdays from 10-11. If you need to speak with [REDACTED] please contact [REDACTED] who is in charge of scheduling appointments with [REDACTED]

Thanks,
Joe

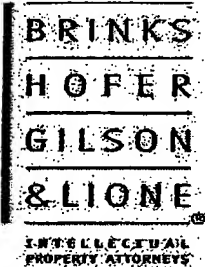
From: Prendergast, William
Sent: Friday, October 28, 2005 4:53 PM
To: Hetz, Joe
Subject: [REDACTED]

Joe,

Thanks for your message. I spoke with PTO earlier this week about this case. I am advised that we can expect a response to our petition to withdraw the erroneous abandonment shortly. They again apologized for the delay as the file was lost (and then reconstructed) and the petition also needed to be resubmitted. We should be able to advance this case in the near future. I will continue to follow up with the PTO on a regular basis. As soon as this issue is resolved, we plan to file a continuation with the approval of [REDACTED]

Could you let me know who I should contact in the absence of [REDACTED]
Thanks.

Bill Prendergast



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Chicago, IL. 60611
wfp@brinkshofer.com
312-321-4242 (phone)
312-321-4299 (fax)

Prendergast, William

From: Prendergast, William
Sent: Wednesday, February 15, 2006 10:52 AM
To: Hetz, Joe
Subject: RE: [REDACTED]

Joe,
I spoke with a supervisor. The case is about to be reviewed. They should pick it up in the next few weeks.
Bill

From: Hetz, Joe
Sent: Thursday, February 09, 2006 11:28 AM
To: Prendergast, William
Subject: RE: [REDACTED]

Bill,

Can you give me an update on this?

Thanks,
Joe

From: Prendergast, William
Sent: Tuesday, January 03, 2006 10:28 AM
To: Hetz, Joe
Subject: RE: [REDACTED]

Joe,
I was out last week for the Holiday. The last I heard we are in the que. I'll call for an update from the Examiner and ask for a more specific date. I will move up the chain if we don't get a satisfactory response. I'll keep you updated.
WFP

From: Hetz, Joe
Sent: Friday, December 23, 2005 10:35 AM
To: Prendergast, William
Subject: RE: [REDACTED]

Hi Bill,

Any word yet?

Thanks
Joe

From: Prendergast, William
Sent: Wednesday, November 30, 2005 8:49 AM
To: Hetz, Joe
Subject: RE: [REDACTED]

I'll get an update.

WFP

From: Hetz, Joe
Sent: Tuesday, November 29, 2005 4:40 PM
To: Prendergast, William
Subject: RE: [REDACTED]

Bill,

Any update on this?

Thanks,
Joe

From: Hetz, Joe
Sent: Monday, October 31, 2005 8:55 AM
To: Prendergast, William
Subject: RE: [REDACTED]

Thanks Bill. I forwarded the information along to [REDACTED]. The new contact is [REDACTED], but he has delegated all prosecution decisions to [REDACTED] a former Brinks attorney who is now one of [REDACTED] outside counsel and works at [REDACTED] on Thursdays. We have a dedicated office hour with [REDACTED] on Thursdays from 10-11. If you need to speak with [REDACTED] please contact Scott Brim, who is in charge of scheduling appointments with [REDACTED].

Thanks,
Joe

From: Prendergast, William
Sent: Friday, October 28, 2005 4:53 PM
To: Hetz, Joe
Subject: [REDACTED]

Joe,
Thanks for your message. I spoke with PTO earlier this week about this case. I am advised that we can expect a response to our petition to withdraw the erroneous abandonment shortly. They again apologized for the delay as the file was lost (and then reconstructed) and the petition also needed to be resubmitted. We should be able to advance this case in the near future. I will continue to follow up with the PTO on a regular basis. As soon as this issue is resolved, we plan to file a continuation with the approval of [REDACTED].
Could you let me know who I should contact in the absence of [REDACTED]?

Thanks.
Bill Prendergast

**BRINKS
HOFFER
GILSON
& LIONE**

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Chicago, IL. 60611
wfp@brinkshofer.com
312-321-4242 (phone)
312-321-4299 (fax)

Prendergast, William

From: Prendergast, William
Sent: Friday, April 07, 2006 6:24 PM
To: Hetz, Joe
Subject: RE: [REDACTED]

Joe,
The contact at the PTO has been out of the office. He will be back next week. I will have an update on this shortly.
Bill

From: Hetz, Joe
Sent: Wednesday, March 29, 2006 9:26 AM
To: Prendergast, William
Subject: RE: [REDACTED]

Bill,

Please update me on this case.

Thanks,
Joe

From: Prendergast, William
Sent: Wednesday, February 15, 2006 10:52 AM
To: Hetz, Joe
Subject: RE: [REDACTED]

Joe,
I spoke with a supervisor. The case is about to be reviewed. They should pick it up in the next few weeks.
Bill

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Sent: Thursday, February 09, 2006 11:28 AM
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Can you give me an update on this?

Thanks,
Joe

From: Prendergast, William
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To: Hetz, Joe
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WFP

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Sent: Friday, December 23, 2005 10:35 AM
To: Prendergast, William
Subject: RE: [REDACTED]

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Any word yet?

Thanks
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To: Hetz, Joe
Subject: RE: [REDACTED]

I'll get an update.
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From: Hetz, Joe
Sent: Tuesday, November 29, 2005 4:40 PM
To: Prendergast, William
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To: Prendergast, William
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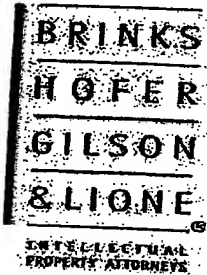
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312-321-4242 (phone)
312-321-4299 (fax)

Prendergast, William

From: Prendergast, William
Sent: Tuesday, May 16, 2006 1:41 PM
To: Hetz, Joe
Subject: RE: [REDACTED]

Joe,
The PTO tells me we can expect an action in about the next two weeks.
Bill

From: Hetz, Joe
Sent: Monday, May 08, 2006 8:22 AM
To: Prendergast, William
Subject: RE: [REDACTED]

Bill,

Can you update me on this?

Thanks,
Joe

From: Prendergast, William
Sent: Friday, April 07, 2006 6:24 PM
To: Hetz, Joe
Subject: RE: [REDACTED]

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Joe

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From: Hetz, Joe
Sent: Thursday, February 09, 2006 11:28 AM
To: Prendergast, William
Subject: RE: [REDACTED]

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Thanks,
Joe

From: Prendergast, William
Sent: Tuesday, January 03, 2006 10:28 AM
To: Hetz, Joe
Subject: RE: [REDACTED]

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Sent: Friday, December 23, 2005 10:35 AM
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To: Hetz, Joe
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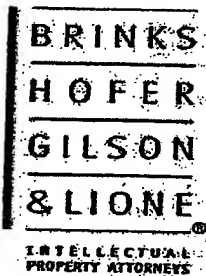
From: Hetz, Joe
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To: Prendergast, William
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Thanks,
Joe

From: Prendergast, William
Sent: Friday, October 28, 2005 4:53 PM
To: Hetz, Joe
Subject: [REDACTED]

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Thanks.
Bill Prendergast



William F. Prendergast
455 N. Cityfront Plaza Dr.
Chicago, IL 60611
wfp@brinkshofer.com
312-321-4242 (phone)
312-321-4299 (fax)

Prendergast, William

From: Prendergast, William
Sent: Monday, July 31, 2006 10:17 AM
To: Hetz, Joe
Subject: RE: [REDACTED]

Joe,
I will request an update. I was expecting something by this point in time. I will keep you advised.
WFP

From: Hetz, Joe
Sent: Friday, July 28, 2006 1:32 PM
To: Prendergast, William
Subject: RE: [REDACTED]

Bill,

Can you update me on this?

Thanks,
Joe

From: Hetz, Joe
Sent: Thursday, June 29, 2006 3:39 PM
To: Prendergast, William
Subject: RE: [REDACTED]

Bill,

Can you update me on this?

Thanks,
Joe

From: Prendergast, William
Sent: Tuesday, May 16, 2006 1:41 PM
To: Hetz, Joe
Subject: RE: [REDACTED]

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Subject: RE: [REDACTED]

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Subject: RE: [REDACTED]

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From: Hetz, Joe
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To: Prendergast, William
Subject: RE: [REDACTED]

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Thanks,
Joe

From: Prendergast, William
Sent: Tuesday, January 03, 2006 10:28 AM
To: Hetz, Joe
Subject: RE: [REDACTED]

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To: Prendergast, William
Subject: RE: [REDACTED]

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Any word yet?

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Joe

From: Prendergast, William
Sent: Wednesday, November 30, 2005 8:49 AM
To: Hetz, Joe
Subject: RE: [REDACTED]

I'll get an update.
WFP

From: Hetz, Joe
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To: Prendergast, William
Subject: RE: [REDACTED]

Bill,

Any update on this?

Thanks,
Joe

From: Hetz, Joe
Sent: Monday, October 31, 2005 8:55 AM
To: Prendergast, William
Subject: RE: [REDACTED]

Thanks Bill. I forwarded the information along to [REDACTED]. The new contact is [REDACTED], but he has delegated all prosecution decisions to [REDACTED] a former Brinks attorney who is now one of [REDACTED] outside counsel and works a [REDACTED] on Thursdays. We have a dedicated office hour with [REDACTED] on Thursdays from 10-11. If you need to speak with [REDACTED] please contact Scott Brim, who is in charge of scheduling appointments with [REDACTED].

Thanks,
Joe

From: Prendergast, William
Sent: Friday, October 28, 2005 4:53 PM

To: Hetz, Joe
Subject: 8285-153

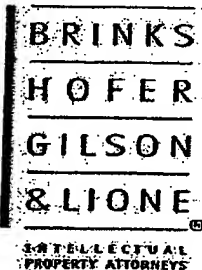
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Could you let me know who I should contact in the absence of [REDACTED]

Thanks,

Bill Prendergast



William F. Prendergast
455 N. Cityfront Plaza Dr.
Chicago, IL 60611
wfp@brinkshofer.com
312-321-4242 (phone)
312-321-4299 (fax)

Prendergast, William

From: Prendergast, William
Sent: Tuesday, September 12, 2006 6:11 PM
To: Lucas, John
Subject: [REDACTED]

John,

I will order a copy of the file. To give you a little background, I spoke with the Office of Petitions this week. I confirmed that they should have everything they need. They promised to get back to me shortly if they had any questions. While I have followed up on this regularly, the PTO had apparently at various times lost the file and the petition we submitted. I think we should be close to getting this matter resolved. Also, once this matter is resolved, which should be shortly, we can talk with Jeff about pursuing some additional claims. Let me know if you want more background on this.

BRINKS
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GILSON
& LIONE

Intellectual Property
Law Worldwide

William F. Prendergast
455 N. Cityfront Plaza Dr.
Chicago, IL 60611
wfp@brinkshofer.com
312-321-4242 (phone)
312-321-4299 (fax)

| Please Note: This message is intended for the individual or entity named above and may constitute a privileged and confidential attorney communication. If you are not the intended recipient, please do not read, copy, use or disclose this communication to others. Also, please notify the sender by replying to this message and then delete it from your system. Thank you. |

Prendergast, William

From: Prendergast, William
Sent: Monday, September 25, 2006 5:25 PM
To: Hetz, Joe
Cc: Lucas, John
Subject: [REDACTED]

Joe,

I spoke with John and wanted to give you an update regarding this matter. As I mentioned previously, I spoke with the Office of Petitions on 9/11/06 to confirm that they have everything they need. I was told that they would contact me shortly if there were any problems and that the matter should be resolved in the near future. The delay has been caused due to various lost items at the PTO. I understand that we need to get this resolved in short order and will follow up on a regular basis. I anticipate setting up a meeting with Jeff in the near future to discuss potential additional claim protection for the invention. I appreciate your patience with this matter. Let me know if you have any questions.
Bill

William F. Prendergast
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Chicago, IL 60611
wfp@brinkshofer.com
312-321-4242 (phone)
312-321-4299 (fax)

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Prendergast, William

From: Prendergast, William
Sent: Sunday, October 22, 2006 2:06 PM
To: Lucas, John
Cc: Hetz, Joe
Subject: RE: [REDACTED]

John,

I was thinking the same thing. I spoke with the PTO on Friday. The case should be picked up shortly. I asked for a written status update that the PTO has agreed to provide. I will forward a copy to client and to you and Joe when it comes in.
Bill

From: Lucas, John
Sent: Saturday, October 21, 2006 9:11 AM
To: Prendergast, William
Subject: [REDACTED]

Hi Bill—

When you get a chance, could you please let us know the status of this case? Thanks, and have a nice weekend.

—John

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Prendergast, William

From: Prendergast, William
Sent: Wednesday, November 22, 2006 4:16 PM
To: Lucas, John
Cc: Hetz, Joe
Subject: RE: [REDACTED]

John,

We have received correspondence from the PTO stating that we can expect an action in the next 1-2 months. I will forward a copy to client. I will also send a copy to you and Joe. Let me know if you have any questions.
Bill

From: Lucas, John
Sent: Monday, November 20, 2006 10:32 AM
To: Prendergast, William
Cc: Hetz, Joe
Subject: RE: [REDACTED]

Bill—

Please advise Joe and me regarding the status of this matter. Thanks.

—John

From: Prendergast, William
Sent: Sunday, October 22, 2006 2:06 PM
To: Lucas, John
Cc: Hetz, Joe
Subject: RE: [REDACTED]

John,

I was thinking the same thing. I spoke with the PTO on Friday. The case should be picked up shortly. I asked for a written status update that the PTO has agreed to provide. I will forward a copy to client and to you and Joe when it comes in.
Bill

From: Lucas, John
Sent: Saturday, October 21, 2006 9:11 AM
To: Prendergast, William
Subject: [REDACTED]

Hi Bill—

When you get a chance, could you please let us know the status of this case? Thanks, and have a nice weekend.

—John

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Prendergast, William

From: Prendergast, William
Sent: Monday, January 29, 2007 5:23 PM
To: Lucas, John
Cc: Hetz, Joe
Subject: RE: [REDACTED]

John,

I wanted to give you a quick update on this matter. The member of PTO petitions branch that is handling that matter has been out of the office since last week. I am told they will be back this week. I will talk to them in short order and provide an update. We should have this resolved shortly.

Bill

William Prendergast
Intellectual Property Attorney
Brinks Hofer Gilson & Lione
NBC Tower, Suite 3600
455 North Cityfront Plaza Drive
Chicago, IL 60611-5599
312.321.4242
312.321.4299 F
wprendergast@usebrinks.com
www.usebrinks.com

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From: Lucas, John
Sent: Tuesday, January 23, 2007 9:02 AM
To: Prendergast, William
Cc: Hetz, Joe
Subject: FW: [REDACTED]

Bill—

Can you please give us an update on this case? Thanks.

From: Prendergast, William
Sent: Wednesday, November 22, 2006 4:16 PM
To: Lucas, John
Cc: Hetz, Joe
Subject: RE: [REDACTED]

John,

We have received to correspondence from the PTO stating that we can expect an action in the next 1-2 months. I will forward a copy to client. I will also send a copy to you and Joe. Let me know if you have any questions.

Bill

From: Lucas, John
Sent: Monday, November 20, 2006 10:32 AM
To: Prendergast, William

Cc: Hetz, Joe
Subject: RE: [REDACTED]

Bill—

Please advise Joe and me regarding the status of this matter. Thanks.

—John

From: Prendergast, William
Sent: Sunday, October 22, 2006 2:06 PM
To: Lucas, John
Cc: Hetz, Joe
Subject: RE: [REDACTED]

John,
I was thinking the same thing. I spoke with the PTO on Friday. The case should be picked up shortly. I asked for a written status update that the PTO has agreed to provide. I will forward a copy to client and to you and Joe when it comes in.
Bill

From: Lucas, John
Sent: Saturday, October 21, 2006 9:11 AM
To: Prendergast, William
Subject: [REDACTED]

Hi Bill—

When you get a chance, could you please let us know the status of this case? Thanks, and have a nice weekend.

—John

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Prendergast, William

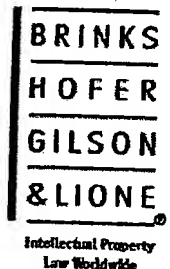
From: Prendergast, William
Sent: Tuesday, February 20, 2007 7:01 PM
To: Lucas, John
Cc: Hetz, Joe
Subject: RE [REDACTED]

John,

I just spoke with Joe and gave him an update on this matter. I received a call from the PTO that they will be picking up the case by next week. I was also promised that they would give me a call if there was issue. The PTO can be very picky about the declarations on these matters. There was a delay in reviewing the case due a health issue with the reviewing member of the petitions office. Let me know if you have any questions.

Bill

William Prendergast
Intellectual Property Attorney
Brinks Hofer Gilson & Lione
NBC Tower, Suite 3600
455 North Cityfront Plaza Drive
Chicago, IL 60611-5599
312.321.4242
312.321.4299 F
wprendergast@usebrinks.com
www.usebrinks.com



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From: Lucas, John
Sent: Monday, February 19, 2007 9:00 AM
To: Prendergast, William
Cc: Hetz, Joe
Subject: [REDACTED]

Bill—

Can you please advise re the status? Thanks.

John K. Lucas
Brinks Hofer Gilson & Lione
NBC Tower, Suite 3600
455 North Cityfront Plaza Drive
Chicago, IL 60611-5599
312.321.4220 - Direct
312.321.4299 - Fax
jlucas@brinkshofer.com

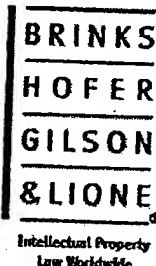
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Prendergast, William

From: Prendergast, William
Sent: Monday, March 12, 2007 2:47 PM
To: Lucas, John
Cc: Hetz, Joe
Subject: RE: [REDACTED]

John & Joe,
Thanks John. That is fine. The PTO advised that they are presently working on the case. We can expect an action to be mailed very shortly. I will keep everyone advised as soon as we receive it.
Bill

William Prendergast
Intellectual Property Attorney
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NBC Tower, Suite 3600
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312.321.4242
312.321.4299 F
wprendergast@usebrinks.com
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From: Lucas, John
Sent: Monday, March 12, 2007 1:43 PM
To: Prendergast, William
Cc: Hetz, Joe
Subject: [REDACTED]

Bill--

Any updates?

I am taking this item off of my personal docket/calendar, but please docket this matter yourself and continue to keep me and Joe Hetz informed re future developments. Thanks.

John K. Lucas
Brinks Hofer Gilson & Lione
NBC Tower, Suite 3600
455 North Cityfront Plaza Drive
Chicago, IL 60611-5599
312.321.4220 - Direct
312.321.4299 - Fax
jluca@brinkshofer.com

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Prendergast, William

From: Prendergast, William
Sent: Thursday, May 10, 2007 5:34 PM
To: Lucas, John
Cc: Hetz, Joe
Subject: RE: [REDACTED]

John & Joe,

We are making some progress. I spoke with PTO about this matter. They asked for a supplemental declaration to address a minor issue which I have taken care of. I have requested an update and will let you know when I hear back.
Bill

William Prendergast
Intellectual Property Attorney
Brinks Hofer Gilson & Lione
NBC Tower, Suite 3600
455 North Cityfront Plaza Drive
Chicago, IL 60611-5599
312.321.4242
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**BRINKS
HOFFER
GILSON
& LIONE**

Intellectual Property
Law Worldwide

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From: Lucas, John
Sent: Wednesday, May 09, 2007 12:02 PM
To: Prendergast, William
Cc: Hetz, Joe
Subject: [REDACTED]

Bill--

Sorry to trouble you again regarding this file, but a couple of months have gone by since we last discussed this file. Would you kindly advise Joe and me on the status? If it is still in the PTO, can we conduct a status inquiry and find out what's going on?

Thaniks

John K. Lucas
Brinks Hofer Gilson & Lione
NBC Tower, Suite 3600
455 North Cityfront Plaza Drive
Chicago, IL 60611-5599
312.321.4220 - Direct
312.321.4299 - Fax
jlucas@brinkshofer.com

Prendergast, William

From: Prendergast, William
Sent: Monday, July 09, 2007 10:31 PM
To: Hetz, Joe
Cc: Lucas, John
Subject: Re: [REDACTED]

Hi Joe,

I thought we would have heard back by now. I will follow up with PTO in the morning. As I mentioned previously, the PTO asked for a minor change in our previous submission that was taken care of. I will keep you advised.
Bill

----- Original Message -----

From: Hetz, Joe
To: Prendergast, William
Cc: Lucas, John
Sent: Mon Jul 09 21:17:39 2007
Subject: RE: [REDACTED]

Bill,

It's been a couple of months -- can you please update us?

Thanks,
Joe

From: Prendergast, William
Sent: Thursday, May 10, 2007 5:34 PM
To: Lucas, John
Cc: Hetz, Joe
Subject: RE: [REDACTED]

John & Joe,

We are making some progress. I spoke with PTO about this matter. They asked for a supplemental declaration to address a minor issue which I have taken care of. I have requested an update and will let you know when I hear back.
Bill

William Prendergast
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From: Lucas, John
Sent: Wednesday, May 09, 2007 12:02 PM
To: Prendergast, William
Cc: Hetz, Joe
Subject: [REDACTED]

Bill--

Sorry to trouble you again regarding this file, but a couple of months have gone by since we last discussed this file. Would you kindly advise Joe and me on the status? If it is still in the PTO, can we conduct a status inquiry and find out what's going on?

Thaniks

John K. Lucas
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From: Hetz, Joe
Sent: Monday, July 23, 2007 1:53 PM
To: Prendergast, William
Cc: Lucas, John
Subject: RE: Voice Mail Message (4719) (4 seconds)

Thanks Bill.

-----Original Message-----

From: Prendergast, William
Sent: Monday, July 23, 2007 1:52 PM
To: Hetz, Joe
Subject: Re: Voice Mail Message (4719) (4 seconds)

Joe,
I will be back in the office tomorrow and will have the file sent to you. I had a message from the PTO on Friday that they were mailing the action. I am expecting to receive the action in the next day or two. I will keep you advised.
Bill

----- Original Message -----

From: Hetz, Joe
To: Prendergast, William
Cc: Lucas, John
Sent: Mon Jul 23 13:31:32 2007
Subject: RE: Voice Mail Message (4719) (4 seconds)

Bill,

I needed to provide John with an update today, but I didn't hear back from you last week. We just left a message for you with your secretary. Can you let us know when we can get an update and see the file?

Thanks,
Joe

-----Original Message-----

From: Hetz, Joe
Sent: Wednesday, July 11, 2007 4:59 PM
To: Prendergast, William
Subject: RE: Voice Mail Message (4719) (4 seconds)

Sounds good. Thanks.

-----Original Message-----

From: Prendergast, William
Sent: Wednesday, July 11, 2007 4:59 PM

-----Original Message-----

From: Lucas, John
Sent: Wednesday, July 25, 2007 10:23 AM
To: Prendergast, William
Cc: Hetz, Joe
Subject: FW: Voice Mail Message (4719) (4 seconds)

Bill--

Please send the file to Joe immediately for his review, and I will look at it when he is finished. Thanks.

--John

-----Original Message-----

From: Hetz, Joe
Sent: Wednesday, July 25, 2007 10:14 AM
To: Lucas, John
Subject: FW: Voice Mail Message (4719) (4 seconds)

John,

I haven't received the file or any further word from Bill. Can you please follow-up?

Thanks,
Joe

-----Original Message-----

From: Hetz, Joe
Sent: Monday, July 23, 2007 1:53 PM
To: Prendergast, William
Cc: Lucas, John
Subject: RE: Voice Mail Message (4719) (4 seconds)

Thanks Bill.

-----Original Message-----

From: Prendergast, William
Sent: Monday, July 23, 2007 1:52 PM
To: Hetz, Joe
Subject: Re: Voice Mail Message (4719) (4 seconds)

Joe,

I will be back in the office tomorrow and will have the file sent to you. I had a message from the PTO on Friday that they were mailing the action. I am expecting to receive the action in the next day or two. I will keep you advised.
Bill

T-Mobile

Customer Service Number [REDACTED] 97

Aug 08, 2007

Itemized Details For:
Account Number: [REDACTED]

Page 8 of 12

Customer Service Number [REDACTED] 97

Aug 08, 2007

Itemized Details For:
Account Number: [REDACTED]

Page 12

3040

LOCAL AIRTIME, LONG DISTANCE and INTERNATIONAL CHARGES (Continued)

Call	Call	Time	Number	Call	Minutes	Airtime	Toll	Total
Destination	Called	Type	Charges	Charges				

LOCAL AIRTIME, LONG DISTANCE and INTERNATIONAL CHARGES (Continued)

Call	Call	Time	Number	Call	Minutes	Airtime	Toll	Total
Destination	Called	Type	Charges	Charges				



Call Types: (A) Call Waiting (B) Call Forward (C) Conference Call (E) Data/Fax (F) Mobile-to-Mobile (G) Voicemail (H) Free Calls
(I) WTS Calls (J) Unavailable (K) Other

Call Types: (A) Call Waiting (B) Call Forward (C) Conference Call (E) Data/Fax (F) Mobile-to-Mobile (G) Voicemail (H) Free Calls
(I) WTS Calls (J) Unavailable (K) Other

Prendergast, William

From: Prendergast, William
Sent: Wednesday, July 25, 2007 1:01 PM
To: Hetz, Joe; Lucas, John
Subject: Fw: Voice Mail Message (23 seconds)
Attachments: Avaya Unified Messenger

Gentlemen,
Good news.

Per the attached message from the PTO, I think we have [REDACTED] resolved. Joe I will call you to follow up.
Bill

----- Original Message -----

From: External Caller (AMM11)
To: Prendergast, William
Sent: Wed Jul 25 12:43:52 2007
Subject: Voice Mail Message (23 seconds)

<<Avaya Unified Messenger>>

To listen to this voice message, double click on the attached and/or save the attached file and open it with Sound Recorder or Media Player.

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Transcript of 7/25/2007 voice mail message (prepared by DSF, 10-12-08)

**"Mr. Prendergast, this is Examiner Williams. I'm returning your call regarding
serial number inventor ; your reference**

**I wanted to let you know that we have granted your petition
and will be, uh, mailing it out to you today."**

From: Hetz, Joe
Sent: Thursday, August 09, 2007 2:35 PM
To: Prendergast, William
Cc: Lucas, John; Brim, Scott
Subject: RE: Voice Mail Message (4242) (48 seconds)

Thanks Bill. I checked the docket system and don't see any record of the granted petition. When did we receive it? Does docketing have it yet?

Please coordinate with Scott regarding contact procedures with [REDACTED]. I'm not sure who you called, but I just want to make sure we follow the correct procedures.

Also, since I assume the patent is now on track to issue, we need to make sure we file the new continuation application before the patent issues. Is the new continuation ready to go? Do we know when the patent will issue?

In any event, please coordinate with Scott regarding next steps.

Thanks again,
Joe.

From: Prendergast, William
Sent: Thursday, August 09, 2007 2:22 PM
To: Hetz, Joe
Subject: RE: Voice Mail Message (4242) (48 seconds)

Hi Joe,
I was faxed over the granted petition. I will get you copy. I have a call in to our new contact to follow up on the next steps.
Bill

William Prendergast
Intellectual Property Attorney
Brinks Hofer Gilson & Lione
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From: Hetz, Joe
Sent: Thursday, August 09, 2007 2:35 PM
To: Prendergast, William
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Subject: RE: Voice Mail Message (4242) (48 seconds)

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Joe

From: Prendergast, William
Sent: Thursday, August 09, 2007 2:22 PM
To: Hetz, Joe
Subject: RE: Voice Mail Message (4242) (48 seconds)

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-----Original Message-----

From: Prendergast, William

Sent: Thursday, August 09, 2007 2:43 PM

To: Hetz, Joe

Cc: Lucas, John; Brim, Scott

Subject: Re: Voice Mail Message (4242) (48 seconds)

Hi Joe,

We just received it. I have sent it down to be docketed. I will touch base with Scott to make sure we file any continuations. I expect it will take several months before issue but will confirm with the PTO.
Bill

----- Original Message -----

From: Hetz, Joe

To: Prendergast, William

Cc: Lucas, John; Brim, Scott

Sent: Thu Aug 09 14:34:45 2007

Subject: RE: Voice Mail Message (4242) (48 seconds)

Thanks Bill. I checked the docket system and don't see any record of the granted petition. When did we receive it? Does docketing have it yet?

Please coordinate with Scott regarding contact procedures with [REDACTED] I'm not sure who you called, but I just want to make sure we follow the correct procedures.

Also, since I assume the patent is now on track to issue, we need to make sure we file the new continuation application before the patent issues. Is the new continuation ready to go? Do we know when the patent will issue?

In any event, please coordinate with Scott regarding next steps.

Thanks again,
Joe

From: Prendergast, William

Sent: Thursday, August 09, 2007 2:22 PM

To: Hetz, Joe

Subject: RE: Voice Mail Message (4242) (48 seconds)

Hi Joe,

I was faxed over the granted petition. I will get you copy. I have a call in to our new contact to follow up on the next steps.
Bill

-----Original Message-----

From: Hetz, Joe
Sent: Monday, September 10, 2007 4:45 PM
To: Prendergast, William
Cc: Lucas, John
Subject: RE: Voice Mail Message (4242) (48 seconds)

Bill,

Can you let us know when you will be sending this? It's been over a month now...

Thanks,
Joe

-----Original Message-----

From: Prendergast, William
Sent: Saturday, September 01, 2007 12:25 PM
To: Hetz, Joe
Cc: Lucas, John
Subject: Re: Voice Mail Message (4242) (48 seconds)

Sure.

----- Original Message -----

From: Hetz, Joe
To: Prendergast, William
Cc: Lucas, John
Sent: Sat Sep 01 12:05:02 2007
Subject: RE: Voice Mail Message (4242) (48 seconds)

Bill,

Can you please send a copy of the granted petition to John and me? We haven't received a copy yet.

Thanks,
Joe

From: Prendergast, William
Sent: Thursday, August 09, 2007 2:22 PM
To: Hetz, Joe
Subject: RE: Voice Mail Message (4242) (48 seconds)

Hi Joe,

I was faxed over the granted petition. I will get you copy. I have a call in to our new contact to follow up on the next steps.

-----Original Message-----

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Sent: Monday, September 10, 2007 4:45 PM
To: Prendergast, William
Cc: Lucas, John
Subject: RE: Voice Mail Message (4242) (48 seconds)

Bill,

Can you let us know when you will be sending this? It's been over a month now...

Thanks,
Joe

-----Original Message-----

From: Prendergast, William
Sent: Saturday, September 01, 2007 12:25 PM
To: Hetz, Joe
Cc: Lucas, John
Subject: Re: Voice Mail Message (4242) (48 seconds)

Sure.

----- Original Message -----

From: Hetz, Joe
To: Prendergast, William
Cc: Lucas, John
Sent: Sat Sep 01 12:05:02 2007
Subject: RE: Voice Mail Message (4242) (48 seconds)

Bill,

Can you please send a copy of the granted petition to John and me? We haven't received a copy yet.

Thanks,
Joe

From: Prendergast, William
Sent: Thursday, August 09, 2007 2:22 PM
To: Hetz, Joe
Subject: RE: Voice Mail Message (4242) (48 seconds)

Hi Joe,

I was faxed over the granted petition. I will get you copy. I have a call in to our new contact to follow up on the next steps.

-----Original Message-----

From: Hetz, Joe
Sent: Monday, September 10, 2007 4:48 PM
To: Prendergast, William
Cc: Lucas, John
Subject: RE: Voice Mail Message (4242) (48 seconds)

Thanks.

-----Original Message-----

From: Prendergast, William
Sent: Monday, September 10, 2007 4:46 PM
To: Hetz, Joe
Cc: Lucas, John
Subject: RE: Voice Mail Message (4242) (48 seconds)

Sorry about the delay. I was out most of last week.
I will have it sent to you by tomorrow.

William Prendergast
Intellectual Property Attorney
Brinks Hofer Gilson & Lione
NBC Tower, Suite 3600
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312.321.4242
312.321.4299 F
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-----Original Message-----

From: Hetz, Joe
Sent: Monday, September 10, 2007 4:45 PM
To: Prendergast, William
Cc: Lucas, John
Subject: RE: Voice Mail Message (4242) (48 seconds)

Bill,

Can you let us know when you will be sending this? It's been over a month now...

EXHIBIT 9

Declaration of David S. Fleming in Support of the Petition to Revive



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): David A. Connolly

Title: WIRELESS DIGITAL PERSONAL COMMUNICATIONS SYSTEM HAVING VOICE/DATA/IMAGE TWO-WAY CALLING AND INTERCELL HAND-OFF PROVIDED THROUGH DISTRIBUTED LOGIC RESIDENT IN PORTABLE HANDSET TERMINALS, FIXED TERMINALS, RADIO CELL BASE STATIONS AND SWITCHED TELEPHONE NETWORK

App. No.: 08/926,187

Filed:

Sept. 8, 1997

Examiner: Trost, William G.

Group Art Unit:

2744

Atty. Dkt. No.: 1033-A00223-C2

MS: Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**DECLARATION OF DAVID S. FLEMING IN SUPPORT OF PETITION TO
REVIVE U.S. PATENT APPLICATION NO. 08/926,187**

1. I am an attorney and a shareholder of Brinks Hofer Gilson & Lione ("Brinks").
2. I participated in Brinks' investigation of apparent misconduct by William F. Prendergast with respect to various client matters. Brinks learned of suspicious conduct by Mr. Prendergast in August 2008. Beginning on August 8, 2008, Brinks conducted an extensive examination of Mr. Prendergast's work on patent applications throughout his employment with Brinks, an 18-year period from 1990 until 2008. Brinks reviewed a large volume of documents relating to Mr. Prendergast's work, including docket files and reports, time records for matters on which he worked dating back to 2000, thousands of e-mail messages in his Outlook Inbox dated back to 2000, and documents located in and near Mr. Prendergast's office.

3. I am familiar with the docketing practices of Brinks and the docket records referred to in this declaration.
4. The Brinks docket records for the above cited Application include an apparently falsified Issue Fee Transmittal, signed by Mr. Prendergast and dated October 15, 1999, and a return post card purportedly stamped by the United States Patent and Trademark Office ("USPTO") on November 5, 1999 (copies of which are attached at EXHIBIT 2).
5. Pursuant to Brinks' docket practices in 1999, a docket card, referred to as a "pink card" because of its color, would be sent to the Docket Department when a filing in the USPTO was made in connection with an open docket item. The Docket Department would not clear a due date from the docket until it received the pink card with the initials or signature of the attorney (and secretary, if applicable) who completed the filing. Pink cards sometimes would be provided to the Docket Department without the document that was to be filed, in which case the Docket Department would write "Did Not See" on the pink card.
6. The Brinks docket records for the above cited Application include a pink card that was initialed by Mr. Prendergast, indicating that the Issue Fee was mailed on October 15, 1999 (a copy of which is attached at EXHIBIT 10). An employee in the Docket Department entered the notation "Did Not See" on the pink card, indicating that no one in the Docket Department saw the filing with the USPTO; Mr. Prendergast apparently represented to the Docket Department that he had mailed the Issue Fee himself.
7. The Brinks docket records for the above cited Application include an apparently falsified Petition for Withdrawal of the Erroneous Holding of Abandonment signed by Mr. Prendergast on August 22, 2000, and a return post card purportedly stamped by the USPTO on August 25, 2000 (copies of which is attached at EXHIBIT 7).
8. In a series of exchanges from 2004 through early 2007, the supervising shareholder (Joseph Hetz) and/or Brinks' general counsel (John Lucas) wrote to Mr.

Prendergast for updates regarding the above cited Application, and Mr. Prendergast responded to these requests with explanations of the application's supposed status. Many of Mr. Prendergast's responses referred to communications that he claimed to have had with the USPTO. In July 2007, Mr. Lucas instructed Mr. Prendergast to send the file for this application to Mr. Hetz immediately for review by Mr. Hetz and then by Mr. Lucas. Mr. Prendergast sent an email to Mr. Hetz and Mr. Lucas, forwarding a voice mail message "from the PTO" stating "I think we have [the matter] resolved." The voice mail was purportedly from "Examiner Williams," and stated that a petition had been granted and would be mailed that day. Mr. Prendergast's cell phone statement for that day discloses that Mr. Prendergast made a one-minute call from his cell phone to his office number at the time of the voice mail. Based on this information and a comparison of the voice mail message and Mr. Prendergast's voice, Brinks believes that the voice mail message in fact was created by Mr. Prendergast. (See documents attached at EXHIBIT 8.)

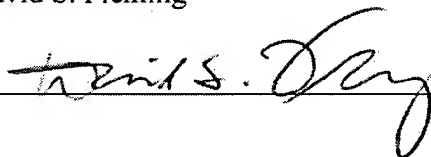
9. During its investigation, Brinks identified 86 matters handled by Mr. Prendergast that required further investigation, including matters filed in the USPTO and matters filed outside the United States. A redacted listing of these matters, as of October 15, 2008, is attached at EXHIBIT 6.
10. Brinks determined in its investigation that:
 - a. 28 matters handled by Mr. Prendergast in the USPTO apparently were abandoned without proper authorization from the client.
 - b. In 17 of the 28 abandoned matters referred to in sub-paragraph a., it appears that Mr. Prendergast attempted to cover up the abandonments by making false written or oral statements to Brinks and/or to the affected client.
 - c. In 8 other USPTO matters, Mr. Prendergast apparently filed fabricated documents and/or made false statements to avoid abandonments.

- d. 25 other matters that were abandoned in the USPTO presented evidence that Mr. Prendergast may have allowed applications to be abandoned without proper client authorization and/or made false statements in connection with those matters.
11. Brinks informed the affected clients of the matters identified in paragraphs 9 and 10.
12. On October 15, 2008, Brinks personally delivered its report concerning Mr. Prendergast's conduct to the Illinois Supreme Court's Attorney Registration and Disciplinary Commission and mailed a copy of the report via overnight delivery to the USPTO's Office of Enrollment and Discipline ("OED").

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Title 18, United States Code, § 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of Declarant: David S. Fleming

Declarant's Signature: _____



Date: May 18, 2009

Mailing Address:

455 N. Cityfront Plaza Drive
NBC Tower - Suite 3600
Chicago, IL 60611-5599

EXHIBIT 10

Copy of Brinks Hofer Gilson and Lione docket "pink card" for Application

TO DOCKET CLERK:

CHECKED:

Did Not Log

PTO ENVELOPE

DIARY/COMPUTER

ENTERED ON WORKING CARD

NOTICE OF MAILING TO PATENT OFFICE

APPLICANT:

Connolly et al.

CLIENT/MATTER NO:

8285/153

PARENT CASE

CLIENT/MATTER NO:

ITEM(s) MAILED:

Issue Fee & Formal paper

DATE DUE:

10/15/99

DATE OF MAILING:

10/15/99

CHECK IF EXPRESS MAIL ☐ Express Mail Label Number

MEMO TO

SECY

INT'L

WFP

ATTORNEY/SECRETARY